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TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1889.

No. 351. 61

THE COUNTY OF FOND DU LAC, PLAINTIFF IN ERROR,

vs.

SARAH MAY.

IN ERROR TO THE CIRCUIT COURT OF THE UNITED STATES FOR
THE EASTERN DISTRICT OF WISCONSIN.

FILED JULY 14, 1887.

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1 Circuit Court of the United States for the Eastern District of Wisconsin.

UNITED STATES OF AMERICA, *Eastern District of Wisconsin,* } *ss:*

At a stated term of the circuit court of the United States for the eastern district of Wisconsin, begun and held, according to law, at the city of Milwaukee, in said district, on the first Monday (being the fourth day) of January, A. D. 1886—present, the Honorable Charles E. Dyer, district judge, presiding—among other, the following proceedings were had, to wit:

SARAH MAY
vs.
THE COUNTY OF FOND DU LAC. } At Law.

Be it remembered that heretofore, to wit, on the 26th day of September, A. D. 1885, came the above-named Sarah May, by her attorney, Mr. Hazelton, and filed her *præcipe* for a summons, together with complaint to be served, and bond for costs, approved by the clerk; and said *præcipe* is as follows:

Præcipe for Summons.

Circuit Court of the United States for the Eastern District of Wisconsin.

SARAH MAY
vs.
THE COUNTY OF FOND DU LAC. }

Issue summons in the above-entitled cause; complaint served.

2 G. W. HAZELTON,
Pl'ff's Att'y.

To Edward Kurtz, clerk.

Whereupon a summons issued, returnable according to law, with said complaint annexed; which summons and complaint are as follows:

Summons.

Circuit Court of the United States for the Eastern District of Wisconsin.

SARAH MAY, Plaintiff,
vs.
THE COUNTY OF FOND DU LAC, Defendant.

The President of the United States of America to the said defendant:

[SEAL.] You are hereby summoned to appear within twenty days after service of this summons, exclusive of the day of service, and defend the above-entitled action in the court aforesaid; and in case of your failure so to do judgment will be rendered against you according to the demand of the complaint, of which a copy is herewith served upon you.

The marshal of said district is hereby commanded to serve this summons and make due return thereto.

Witness the Hon. Morrison R. Waite, Chief Justice of the Supreme Court of the United States, at the city of Milwaukee, in the said eastern district of Wisconsin, this 26th day of September, in the year of our Lord one thousand eight hundred and eighty-five, and of the Independence of the United States the 110th.

EDWARD KURTZ, *Clerk.*

3 G. W. HAZELTON,
Plaintiff's Attorney.

P. O. address, Milwaukee, Wis.

Complaint.

UNITED STATES OF AMERICA:

The Circuit Court of the United States of America for the Eastern District of Wisconsin.

SARAH MAY, Plaintiff,
v.
THE COUNTY OF FOND DU LAC, Defendant.

The plaintiff, Sarah May, complains of the defendant, The County of Fond du Lac, and alleges that she is a citizen of the State of Illinois, residing in the city of Chicago, in said State, and that the defendant is a corporation, resident in the State of Wisconsin and in the eastern district of said State, and is a citizen of said last-named State.

And the plaintiff alleges that Edwin May, of the city of Indianapolis, in the State of Indiana, was before and at the time of his application for the hereinafter-mentioned letters patent a citizen of the United States, and was the true, original, first, and only in-

ventor of a certain new and useful apparatus described in the specifications of the letters patent hereinafter mentioned and named therein "improvements in the construction of prisons," and which was not known or used in this country and not patented or described in any written or printed publication in this or any
4 foreign country before his invention thereof, and was not in
public use or on sale more than two years prior to his application for letters patent of the United States therefor.

That heretofore, to wit, on the 4th day of October, A. D. 1859, letters patent for said invention in due form of law were, on the application of the said Edwin May, issued and delivered to the said Edwin May in the name of the United States of America, numbered 25662, and under the seal of the Patent Office of the United States, and were signed by the Secretary of the Interior of the United States and countersigned by the Commissioner of Patents; that the said letters patent did grant unto the said Edwin May, his heirs and assigns, for the term of fourteen years the exclusive right to make, use, and vend the said invention throughout the United States and the territories thereof; that afterwards and before the 4th day of October, A. D. 1873, the said Edwin May did file his petition in the Patent Office for the extension of said patent for the period of seven years from and after the date last named; and, having complied with the statute in such case made and provided, the Commissioner of Patents, pursuant to law and in accordance with the statutes of the United States then in force, did, on the said 4th day of October, 1873, extend the said patent for the term of seven years from and after the said 4th day of Oc-
5 tober, 1873, and did attach to said original letters patent his,
the said Commissioner's, certificate, duly signed by him, bearing date said 4th day of October, A. D. 1873, as by said letters patent or a duly certified copy thereof and as by said extension certificate or a duly certified copy thereof more fully appears, and which plaintiff will present in court in connection with this complaint.

That said extended letters patent did grant unto said Edwin May, his heirs or assigns, for the term of seven years from and after the said 4th day of October, 1873, the exclusive right to make, use, and vend the said invention throughout the United States and the territories thereof.

That on or about the 27th day of February, A. D. 1880, the said Edwin May died in the county of Marion and State of Indiana testate, being at the time of his death the sole owner of said letters patent and the extension thereof and all rights thereunder, both at law and in equity, and being then a resident of said county of Marion.

That afterwards and on the 6th day of March, A. D. 1880, one Edwin Forrest May was, by the circuit court for the said county of Marion, in said State of Indiana, that being the court having jurisdiction of the estates of deceased persons, duly appointed executor of the last will and testament of Edwin May, aforesaid, de-
6 ceased, and thereupon duly qualified and entered upon the
execution of his trust.

That afterwards and on the 7th day of June, 1880, the said Edwin Forrest May having resigned his trust as such executor and his resignation having been accepted by said court, the said court did, on the day last aforesaid, duly appoint George T. McGinnis administrator *de bonis non*, with the will annexed, of all and singular the goods, chattels, credits, and effects of said Edwin May, deceased, as by the letters of administration or a duly certified copy thereof will more fully appear.

That the said administrator, George T. McGinnis, did, on the 30th day of December, 1880, procure from said Marion county circuit court an order in due form of law authorizing and directing him as such administrator to sell all the right, title, and interest, claim, and demand of said estate in, by, under, and through said letters patent and the extension thereof, and that pursuant to said order said administrator did, on or about the 6th day of March, A. D. 1882, sell, transfer, and convey to said plaintiff all the right, title, claim, and demand of said estate of said deceased, including all rights of action and claims for damages of every kind and description which said estate had by reason of said patent and said extension; which
7 said transfer and the instrument of conveyance were duly approved and confirmed by said court, and to which instrument and order of approval plaintiff refers and offers to produce the same or certified copies thereof.

And plaintiff says she is now the sole owner of said patent and of the extension thereof and of all rights thereunder, including all rights of action, both at law and in equity, to recover profits and damages for infringement.

And the plaintiff further says that always hitherto, from the time of the issuing of said original patent, the owner thereof vended to others the right to make and use specimens of said invention to the great advantage and profit of the said owner.

The plaintiff further alleges that the defendant is a corporation duly and legally organized, established, and constituted under the laws of the State of Wisconsin, being one of the counties of said State located within said eastern district of Wisconsin.

That the defendant, well knowing the premises, but contriving to injure the plaintiff, heretofore, to wit, on the 4th day of October, 1873, and up to and on the 4th day of October, 1880, and within and during the term of seven years mentioned in the certificate of extension of said letters patent, and after the granting of said letters patent and said extension, and before the bringing of this suit,
8 and within the district aforesaid, unlawfully, wrongfully, and injuriously and with intent to deprive the plaintiff and her assignor of the royalties which she and her said assignor might and otherwise would have derived from the sale of rights to make and use specimens of the apparatus covered by said letters patent and extension thereof, and without license of the plaintiff or any other person authorized to grant license, and against the title of the plaintiff and her assignor, did make and use and cause to be made and to be used sundry specimens of said apparatus and of machines which contained and employed substantially the invention*ed* cov-

ered by said patent in infringement of said exclusive rights secured as aforesaid to said Edwin May by the letters patent aforesaid and the extension thereof and granted by said administrator to the said plaintiff, as hereinbefore set forth, and contrary to the statute of the United States in such case made and provided, whereby the plaintiff has been deprived of the reasonable royalty upon the infringing apparatus so used and caused to be used by the defendant and of large royalties which she might and otherwise would have derived from the sale of rights to make and use specimens of said apparatus and has sustained actual damage thereby to the extent of 9 three thousand dollars.

Wherefore, by force of the statutes of the United States, a right of action has accrued to the said plaintiff to recover the said actual damages and such additional amount, not exceeding in the whole three times the amount of said actual damages, as the court may see fit to adjudge and award, besides costs.

That the defendant, though often requested, has not paid said damages nor any part thereof, but has refused and still refuses to pay the same.

Wherefore the plaintiff demands judgment against the defendant for said damages, with costs of suit.

G. W. HAZELTON,
Pl'ff's Att'y.

Return.

Summons & complaint returned.

"Served on the within-named The County of Fond du Lac by showing Mark Crane, county clerk of said county, this summons and complaint and by delivering to him personally a copy thereof, this 29th day of September, A. D. 1885.

F. H. WEST, *Marshal.*"

Fees, $7.56.

DECEMBER 12, 1885.

This day came the defendant, by its attorneys, Messrs. F. F. Duffy and Shepard & Shepard, and filed its answer as follows:

Answer.

Circuit Court of the United States, Eastern District of Wisconsin.

10 SARAH MAY
v.
THE COUNTY OF FOND DU LAC.

Now comes the defendant, by F. F. Duffy and Shepard & Shepard, its attorneys, and for answer to the complaint says that it denies generally and specifically each and every allegation in the complaint, except those as to citizenship and residence of the parties and the corporate character of the defendant.

And for its further defense the defendant alleges that as to so much of the supposed cause of action as is for the alleged infringement of the said alleged patent and for the alleged use of said alleged invention prior to the 29th day of September, 1879, the same did not accrue within six years prior to the beginning of this action, and therefore the time within which an action could be brought for such alleged infringement and use prior to the 29th day of September, 1879, expired before this action was begun, and the action is therefore barred in accordance with the provisions of section 4222 of the Revised Statutes of Wisconsion.

Wherefore the defendant prays judgment that it be hence dismissed without day, with its costs of defense.

F. F. DUFFY AND
SHEPARD & SHEPARD,
Def't's Att'ys.

11 MARCH 5, 1886.

This day came the defendant, by its attorneys, and filed its notice of special matter to be given in evidence at the trial as follows:

Def't's Notice of Special Matter.

In U. S. Circuit Court, Eastern Dist. of Wisconsin.

SARAH MAY
v.
THE COUNTY OF FOND DU LAC.

To G. W. Hazelton, Esq., plaintiff's attorney:

Take notice that on the trial hereof we shall produce evidence to prove that the alleged invention described in the letters patent pleaded in the complaint was not novel and that the said patentee, Edwin May, was not the original and first inventor of the thing in said letters patent patented or of any material or substantial part thereof, and that one Radcliffe, then a prisoner in the State prison at Waupun, in Wisconsin, and a resident thereat, was the inventor of said patented contrivance prior to the said patentee's alleged invention thereof, and that John Taylor, of Waupun, Wis.; Henry Brown, of Fond du Lac, Wis.; Argalus W. Starks, of Baraboo, Wis.; Edward McGarry, of Milwaukee, Wis.; Edward M. MacGraw, of Sheboygan, Wis.; Martin K. Dahl, John N. Ackerman, George Wilcox, Simon Heath, De Witt Brooks, all of Waupun, Wis.; and Manus Mensinck, then of Waupun, Wis., and now of Greenleafton, Fillmore county, Minnesota, had knowledge of the thing by said letters patent
12 patented prior to the alleged invention by the said patentee or his application for said patent, and that said John Taylor, Henry Brown, Argalus W. Starks, Edward McGarry, Edward M. MacGraw, Martin K. Dahl, and Manus Mensinck had use thereof at said Waupun prior to said patentee's alleged invention thereof.

Dated Feb. 26th, 1886.

Yours, &c.,
F. F. DUFFY AND
SHEPARD & SHEPARD,
Defendant's Attorneys.

APRIL 15, 1886.

This day came the defendant, by its attorneys, and filed its additional notice of special matter to be given in evidence at the trial as follows:

Additional Notice.

United States Circuit Court, Eastern District of Wisconsin.

SARAH MAY, Plaintiff,
v.
THE COUNTY OF FOND DU LAC, Defendant.

To G. W. Hazelton, Esq., plaintiff's attorney:

Take notice that on the trial hereof we shall produce evidence to prove that the alleged invention described in the letters patent pleaded in the complaint was not novel and the said patentee, Edwin May, was not the original and first inventor of the thing in said letters patent patented or of any material or substantial part thereof, and that William R. Tallmadge, now of Fond du Lac, Wisconsin, and then of Elmira, Chemung county, New York, had knowl-
13 edge of the thing by said letters patent patented at said Elmira, New York, prior to the alleged invention by said patentee or his application for said patent.

Yours, &c.,
F. F. DUFFY AND
SHEPARD & SHEPARD,
Defendant's Attorneys.

And now, at this same term, to wit, January term, 1886, and on the seventy-fifth day thereof, to wit, on the 13th day of May, A. D. 1886, the following proceedings were had, to wit:

Trial.

SARAH MAY
v.
THE COUNTY OF FOND DU LAC.
At Law.

This day came the parties, by their counsel—Messrs. G. W. Hazelton, Edward Taggart, and M. C. Burch appearing for the plaintiff, and Mr. Charles E. Shepard for the defendant—and the issue herein came on to be tried; whereupon a jury was called to try the same, who came, to wit, L. H. Morehouse, Donald McPherson, Lyman Kellogg, W. N. Pennell, Chester E. Wilcox, J. H. Booth, Edwin Upson, Henry P. Ellis, James Atkins, W. W. Watkins, Frank Nugent, and Charles J. Munkwitz, twelve free, honest, and lawful men of the district, who were severally sworn and empanelled, and the trial not being concluded, the same was adjourned until tomorrow morning.

14 And afterwards, to wit, on the seventy-sixth day of said term, to wit, on the 14th day of May, A. D. 1886, the following proceedings were had, to wit:

Sarah May
vs.
The County of Fond du Lac. } At Law.

This day came the parties, by their counsel, and also the said jurors of the jury, and the trial of the issue herein was resumed, and, not being concluded, the same was adjourned until to-morrow morning.

And afterwards, to wit, on the seventy-seventh day of said term, to wit, on the 15th day of May, A. D. 1886, the following proceedings were had, to wit:

Verdict.

Sarah May
vs.
The County of Fond du Lac. } At Law.

This day came the parties, by their counsel, and also the said jurors of the jury, and the trial of the issue herein was resumed; and the jurors of the jury aforesaid, being charged by the court, retired to their room, under the charge of a sworn officer, to deliberate upon their verdict, and afterwards came into court and on their said oaths respectively do say that they find the issue herein in favor of the plaintiff; that the apparatus used by the defendant in its jail prior to October 4, 1880, and subsequent to October
15 4, 1873, infringed the first, third, and fourth claims of the patent in suit, and that they assess the damages to the said plaintiff at the sum of one thousand seven hundred and seventy-four dollars and sixty-eight cents; and, on motion of the defendant's counsel, it is ordered by the court that he be, and hereby is, allowed twenty days within which to file a motion for a new trial.

And afterwards, to wit, on the ninety-ninth day of said term, to wit, on the 15th day of June, A. D. 1886, the following proceedings were had, to wit:

Sarah May
vs.
The County of Fond du Lac. } At Law.

This day came the parties, by their counsel, and the defendant moved the court for a new trial, and also in arrest of judgment, for reasons filed; which motions are as follows, to wit:

Motion for New Trial.

U. S. Circuit Court, E. D. of Wisconsin.

Sarah May
vs.
The County of Fond du Lac. }

Now comes the defendant, to wit, on June 15, 1886, being yet of the January term, 1886, at which this action was tried, and moves for a new trial on the grounds that the court erred at the trial—

I. In admitting evidence against the defendant's objection.

15½ II. In excluding evidence offered by the defendant & objected to by the plaintiff.

III. In its charge & instructions to the jury.

IV. In declining to give to the jury instructions requested by the defendant.

V. In not instructing the jury to render a verdict for the defendant.

VI. In ruling that the plaintiff is the owner of the cause of action, and in not ruling that the plaintiff has shown no title to the alleged cause of action.

This motion being made by leave of the court without prejudice to the defendant's right to move for a new trial on the ground of newly discovered evidence hereafter.

F. F. DUFFY AND
SHEPARD & SHEPARD,
Def't's Att'ys.

C. E. SHEPARD, *Of Counsel.*

Motion in Arrest of Judgment.

In U. S. Circuit Court, E. D. of Wisconsin.

SARAH MAY
v.
THE COUNTY OF FOND DU LAC.

And now, to wit, on the 15th day of June, 1886, being yet of the January term of this court, and after entry of an order denying the defendant's motion for a new trial on the alleged grounds of error stated therein, and before entry of the judgment of the court upon the verdict found for the plaintiff at said term, comes the 16 defendant, by its attorneys, and moves the court now here for an order that the entry of judgment upon said verdict be stayed and arrested until further order of the court, upon these grounds of error, apparent upon the face of the record herein, to wit:

I. That the said letters patent granted to the patentee, Edwin May, as in the complaint pleaded, were & are void upon their face, because it appears on the face thereof that none of the several claims therein stated is for a patentable invention, contrivance, or combination, and that none of the several combinations therein stated and claimed as the patentee's inventions is a new or patentable invention.

II. That the plaintiff, Sarah May, does not appear upon the face of the complaint to be or to have ever been the lawful owner of the cause of action sued upon.

June 15, 1886.

F. F. DUFFY AND
SHEPARD & SHEPARD,
Defendant's Attorneys.

Hearing of said Motions and Order Overruling Same.

And said motions came on to be heard and were argued by Mr. Shepard, in favor of the same, and by Mr. Hazelton, in opposition, and submitted. On consideration whereof it is ordered by the court that the said motions based upon rulings made by the court and questions of law arising at the trial be, and hereby are, overruled, but without prejudice to the right of the defendant to move again for a new trial, on the ground of newly discovered evidence, within forty days from this date. 16½

Judgment.

Whereupon it is considered and adjudged by this court, now here, without prejudice as aforesaid, that the plaintiff do have and recover of the defendant, The County of Fond du Lac, the sum of one thousand seven hundred and seventy-four dollars and sixty-eight cents, damages so as aforesaid assessed by the jury, together with ninety-one dollars and seventy-one cents, her costs about her said suit in this behalf by her expended, and that she have execution therefor.

Judgment-roll signed June 15th, A. D. 1886.

EDWARD KURTZ, *Clerk.*

Damages	$1,774 68
Costs	91 71
	$1,866 39

And same day (June 15, 1886) bill of exceptions signed and filed as follows:

17 *Bill of Exceptions.*

U. S. Circuit Court, E. D. Wisconsin.

SARAH MAY
vs.
THE COUNTY OF FOND DU LAC.

Be it remembered that on the 13th day of May, 1886, at a general term of said court in and for said district, begun on the 4th day of January, 1886, and holden at the court-room, in the custom-house, in the city of Milwaukee, in said district, this action came on to be tried before the Hon. Charles E. Dyer, district judge of said district, and a jury duly empaneled to try the cause.

The plaintiff appeared by G. W. Hazelton, Esq., her attorney, and Taggart and M. C. Burch, Esqs., of counsel.

The defendant appeared by F. F. Duffy, Esq., and Messrs. Shepard & Shepard, its attorneys.

And thereupon the following proceedings were had:

The plaintiff, to sustain the issues upon her part, offered in evidence the letters patent of the United States to Edwin May, dated October 4, 1859, and numbered 25662, which are pleaded in the complaint. The same were objected to by the defendant upon the ground that upon the face of the specification and claim accompanying said letters patent they are not for a novel or an operative combination and are invalid, and that this action had not been brought within the time required by law after the expiration of the letters patent.

Objection overruled and defendant excepted.

18 Said letters patent, with specification and claim, were then marked Exhibit A, and a true copy thereof is hereto annexed.

The certificate of the Commissioner of Patents for an extension of said patent from October 4, 1873, to October 4, 1880, dated October 4, 1873, was then offered in evidence by the plaintiff and objected to on the same grounds by the defendant.

Objection overruled and defendant excepted.

Said certificate was then admitted and read and marked Exhibit B. A true copy is hereto attached.

The plaintiff then offered successively and in connection with each other the following documents:

A certified copy of proceedings for letters testamentary issued out of the circuit court of Marion county, Indiana, to Edwin Forest May, as executor of the last will and testament of Edwin May, deceased, dated March 6, 1880.

A certified copy of the resignation of said Edwin Forest May as such executor, dated June 7, 1880, and of the order of court accepting the same.

A certified copy of the letters of administration *de bonis non*, with the will annexed, issued out of the circuit court for Marion county, Indiana, to George F. McGinnis, as administrator *de bonis non*, dated June 7, 1880, and of his bond as such administrator.

A certified copy of the petition of George F. McGinnis to said circuit court for Marion county, Indiana, for authority to said administrator *de bonis non* to make sale of said letters patent No. 25662, dated December 31, 1881.

19 A certified copy of the order of the circuit court for Marion county, Indiana, to said George F. McGinnis, as such administrator *de bonis non*, upon said petition, dated December 31, 1881.

A certified copy from the Patent Office of the deed or instrument of conveyance made upon such sale by said administrator *de bonis non* to the plaintiff, dated March 7, 1882.

A certified copy of said administrator's report of sale and deed and of the order of said circuit court for Marion county, Indiana, confirming said sale and deed, dated March 7, 1882.

To each of which several documents the defendant objected severally and separately that they were singly or collectively immaterial and incompetent and did not tend to vest any title to the cause of action sued on in the plaintiff, and that the jurisdiction of the court wherein said proceedings were had is not shown.

Objections overruled, and said documents were admitted and read in evidence in the order stated, and were marked successively Exhibits C, D, E, F, G, I, H.

To which ruling upon each of said several documents the defendant then severally excepted.

The plaintiff then called as a witness in her behalf LUTHER V. MOULTON, who, being sworn, testified:

I live at Grand Rapids, Michigan; am a partner in a foundry there. I have had experience in mechanics and patents; have photographed models; have been consulted about the patentability of mechanical devices; have been an expert witness in patent causes; have done patent soliciting; am acquainted with the May patent in suit; know its specifications and claims and am acquainted with its practical operation and effect.

20 Models of a jail constructed according to the said letters patent and of the defendant's jail were then introduced by plaintiff and identified as correct except as to the second claim; and in connection therewith was introduced a stipulation in this action between the attorneys for the parties, marked Exhibit J, of which a copy is annexed. Said model of a jail according to said patent was marked Exhibit K, and of the defendant's jail was marked Exhibit L.

The witness then proceeded: In my opinion the model representing the defendant's jail contains the mechanical equivalents of the devices described in the specifications and claimed particularly in the first, third, and fourth claims of the patent in question.

The results produced by the combinations claimed in the patent are produced by substantially the same means.

On cross-examination the witness testified:

The novelty and utility of this patented device consists in interposing a grating or wall between the person operating the mechanism for securing the doors and the prisoners, so that they can be observed through the door or grating and the corridor doors be closed and secured or unlocked and opened or the cell doors can be locked or unlocked, all without any contact between the jailer and the prisoners and without the jailer being in the same apartment with the prisoners, and thus exposed to attack by them.

The several elements of the device are probably old. The novelty consists in the particular combinations whereby a new and useful result is produced.

21 I think an angle door is old; have never seen them in jails; have seen angle doors and curved doors and illustrations of them in books many years ago, before 1859. Locks and bolts upon doors are also old, and to put a lock or bolt upon such a door would not be invention. In defendant's jail the corridor doors are not closed by the fastening mechanism as described in the patent, but, when closed by the prisoners or turnkey, they are locked

by bolts moved by rock-shafts extending from the outer apartment through the wall into the jail proper and to the corridor doors.

There is nothing new in a rock-shaft as applied to the purpose of transmitting motion to bolts or other like uses; it is the equivalent of an endless chain or any other well-known device for transmitting motion; it is very old. The operation and effect of the rock-shaft, the handle or lever that moves it, and the bolts that it moves in connection with the corridor doors thereby locked and unlocked are precisely the same with or without a wall or grating interposed between the handle or lever and the door locked, and also the same as the corresponding parts in the May patent. In the Fond du Lac jail the handle of this rock-shaft and the place where it is operated are a few feet distant from the angle door. There is an embrasure or slit in the wall by these handles to the rock-shafts, through which two corridors, one over the other on one side of the jail, can be observed, but the other side of the jail, with its two corridors and two tiers of cells, cannot be observed. The doors of all four corridors are locked by rock-shafts, all starting and moved from the
22 same point. The operation and effect of the arrangement of the lever (*b*), bar (*a*), and bolts and lugs (S), as described in the patent for locking and unlocking the cell doors, are precisely the same, whether the lever is operated through a wall or grating or whether there is none there. Mechanically the effect is precisely the same with or without the grating, so far as fastening and unfastening the doors is concerned. The only difference is in the effect of the grating to protect the jailer and guard against escapes. Every separate element of the combination of the fourth claim is old—the bar, the lever, the lugs or bolts, and the grating. Levers have long been used, long before this patent, to move a long bar and thereby to move bolts, lugs, or the like at a distance; so also similar devices passing through a wall to open and close and secure window shutters and the like, but the particular combination adapted to interpose protection between the person operating the device and those on the other side of the wall or grating was new and patentable and so patented to Mr. May. The grating has nothing to do directly with locking or unlocking the doors. It affords protection to the operator while so doing. So with the second claim in suit, which is the third of the patent. All its separate elements are old. It is only the particular combination applied to this purpose that is new and patentable.

The plaintiff then, further to maintain the issues on her part, gave evidence tending to show that the patentee, Edwin May, died on February 27, 1880, and the plaintiff is his widow; that said
23 patented contrivance is useful and economical; that it is in use, and has been for much of the time since it was patented, in sundry jails and prisons in this country; that at the Grand Rapids (Kent Co.), Mich., jail and elsewhere it has resulted in a saving of time and labor; that the said patentee during his lifetime and the plaintiff since his death have established and collected a royalty of $50 per cell, both where there has been previous infringement of the

patent and the infringers have settled and where the county or the builder of the jail has desired to purchase the right.

But it was not shown that such royalties or any royalties had been paid for the use of the angle observation door under the first claim or of the combination claimed in the third claim, or that such royalties or any royalties had been paid simply for the use of the combination described and claimed in the fourth claim, irrespective of the use of the angle observation door or the contrivance for closing and locking the corridor doors in the same jail at the same time and without the use thereof or of either of them in the same jail at the same time.

The plaintiff also, by a question to a witness, proposed to prove that the defendant had used the said contrivances, as claimed in the first, third, and fourth claims, since 1869.

To which the defendant objected, on the ground that the statute of limitations of Wisconsin (subdivisions 3, 4, and 5, section 4222,
Revised Statutes of Wisconsin of 1878) had run upon the
24 alleged cause of action for infringement prior to September
29, 1879, which was six years prior to the beginning of this
action, and requested the court to limit the proof of such use to that which has occurred since September 28, 1879.

Which objection and request were overruled, and the defendant objected thereto.

And it was thereupon proved that the defendant had used in its jail ever since 1869 the outside angle door, the contrivance for locking and unlocking the corridor doors, and the contrivance for locking and unlocking the cell doors which are exhibited by the model of its jail, Exhibit L, and are hereinabove described.

The plaintiff then offered in evidence a certified copy of the pleadings and charge of court to jury in the case of Edwin May *vs.* Johnson County, Indiana. Objected to by defendants as irrelevant and immaterial. Overruled, and defendant excepted.

The said copy was then admitted and read and marked Exhibit M.

The plaintiff then rested her case.

Whereupon the defendant moved that a verdict be directed for the defendant on the grounds that—

1. The plaintiff has established no cause of action against the defendant.

2. The patent in suit is void for lack of novelty and because the combinations described are not operative combinations, and are old and well known devices long applied to similar uses.

3. The plaintiff is not the owner of the cause of action sued on.

25 4. The statute of limitations of Wisconsin has run upon the alleged cause of action.

Which motion was overruled and the defendant excepted.

Thereupon, to sustain the issues upon its part, the defendant proved that there were no more than thirty-four cells in its jail on which the device of locking by a bar with lugs or bolts attached to it and operated by a lever on the outer side of a corridor grating is or has been used; that the same was put on when the building was constructed, in 1869, and by the contractors who built said jail under contract; that at the Wisconsin State prison, at Waupun, the Elmira (N. Y.) or Chemung county jail, and elsewhere there had been in common and public use, well known to many persons for many years before 1859, a device consisting of a lever, a bar, and lugs or bolts attached, operated substantially as described in said patent, to lock or unlock the cell doors, but without any intervening wall, corridor grating, or other protection to the jailer against attack; that such device, except for the absence of a corridor wall or grating, was substantially identical and a mechanical equivalent of the device described in said patent and claimed in the fourth claim thereof, and that it was used and did operate in the same way to lock or unlock the cell doors after they had been closed.

The defendant then closed its case.

26 No evidence in rebuttal was offered by the plaintiff, and the foregoing is all the evidence on either side.

The testimony was then closed.

Thereupon the defendant renewed its motion for a verdict to be directed for the defendant on the same grounds above stated; which motion was denied and the defendant excepted.

The defendant then prayed that the jury be instructed as follows, and each of such instructions was severally refused, and the defendant excepted severally to such rulings, as follows:

I. The first claim of the patent is void.

Which instruction the court then refused to give and the defendant then excepted to such refusal.

II. The third claim of the patent is void.

Which instruction the court then refused to give and the defendant excepted to such refusal.

III. The fourth claim of the patent is void.

Which instruction the court then refused to give and the defendant excepted to such refusal.

IV. The first claim does not claim a new device nor is the combination described and thereby claimed an operative combination, but it is a mere aggregation.

Which instruction the court then refused to give and the defendant then excepted to such refusal.

V. The third claim does not describe a new device.

Which instruction the court then refused to give and the defendant then excepted to such refusal.

VI. It is for the jury to decide whether the third claim is infringed by the defendant's device.

27 Which instruction the court then refused to give and the defendant then excepted to such refusal.

VII. It is a question for the jury whether there was an invention or exercise of the inventive faculty in the construction of the devices described in the patent.

Which instruction the court then refused to give and the defendant then excepted to such refusal.

VIII. The plaintiff cannot recover for any use of the patented contrivances of the plaintiff or of any of them prior to the 29th day of September, 1879, because for any such prior use the action was not brought within the six years prescribed by the statutes of Wisconsin.

Which instruction the court then refused to give and the defendant then excepted to such refusal.

IX. Confining the period for which recovery can be had to that between September 29, 1879, and October 4, 1880, the jury are entitled in assessing the damages to consider the length of use and to allow less damages in their discretion for that amount of use than the royalty established by the patentee, or less than would be a proper measure of compensation for a longer use.

Which instruction the court then refused to give and the defendant then excepted to such refusal.

X. The royalty asked and paid is not conclusive on the
28 jury. The jury are to take into consideration the time and
extent of infringement, and may allow less than the regular royalty for a time materially shorter than the period of the patent, and it is for the jury to decide on the amount of damages.

Which instruction the court then refused to give and the defendant then excepted to such refusal.

29 And thereupon the court instructed the jury as follows:

This is a suit at law to recover damages for the alleged infringement of a patent granted to Edwin May on the 4th day of October, 1859. As you are all aware, when a party invents a new and useful improvement the laws of the United States provide that for a limited term of years he shall have an exclusive property right in such invention, which means the sole and exclusive privilege of manufacturing, using, and selling the same.

* * * * * * *

The laws of the United States on this subject are designed to encourage meritorious and useful inventions and to protect their owners in the profitable enjoyment of them during the period fixed by the statute. If, therefore, a new and useful invention covered by a valid patent is exhibit- in this case, and if the defendant has unlawfully pirated upon it, the plaintiff is entitled to recover damages on account of such invasion of her rights the same as if she had suffered disturbance of any other property right. As I have said, the patent in suit was granted October 4, 1859. The term of the patent, as then established by law, was fourteen years, so that the original term expired October 4, 1873; but, as provided by law, the patent was renewed and extended for the further term of seven years from and after the the expiration of the first term, so that the patent continued in force until the 4th day of October, 1880, when it finally expired. It seems that on the 27th day of February, 1880, the patentee, Edwin May, died, and in the course of administration of his estate there was a sale of all rights under
30 the patent by the administrator to the plaintiff, who became
the owner in law on the 6th day of March, 1882, of all rights

of action and claims for damages on account of infringements of the patent which accrued prior to October 4, 1880.

It is charged by the plaintiff that between the 4th day of October, 1873, when the patent was extended, and the 4th day of October, 1880, when it finally expired, the defendant, The County of Fond du Lac, wrongfully and without license from the plaintiff or her assignor or the patentee used a mechanical apparatus which was an infringement of the patent, and it is on account of this alleged use that the plaintiff seeks to recover damages. The patent relates to an alleged new and useful improvement in the construction and operation of prisons. The evident object of the improvement is to avoid the necessity of actual contact with the prisoners, while the keeper can observe their movements and with security to himself control them. The patent is what is known as a combination mechanical patent, and the utility of the thing or things patented is apparent, I think, at a glance. To construct a jail or prison so that prisoners can be safely kept and their movements controlled, and so that the jailer is at the same time secured from violence, is without doubt a beneficial object. A model of the patentee's improvement has been exhibited to you. In practical operation of the alleged invention, as stated in the specifications of the patent, the jailer, upon going into the outside entrance, is separated from the hall or room in which the prisoners may be by an angle door, which is locked, and which, from its peculiar shape, enables him to observe all parts of the hall and the movements of the
31 prisoners. Upon opening a small side door (which side door
has no relation to the patent) he has access to a crank which operates the doors in the partition between the first room and the rooms adjoining the cells by means of an endless chain or rope which passes around a drum and is attached to a hinge or joint of a lever connected with the partition doors. Prisoners in the first room or hall being ordered to retire through these doors, the doors are then fastened by operating the crank before mentioned. The keeper may then unlock the angle door and pass into the first hall or corridor, and is separated from the prisoners by the partition between it and the room beyond. Then, the prisoners being ordered to their respective cells, the doors of the cells may be fastened by operating a lever in the first corridor connected with bars, which, upon being drawn by means of connecting bolts, secure the doors. The keeper may then pass in and lock the cell doors, and thus a partition of iron grating is all the time kept between the prisoners and the keeper.

There are four claims in the patent, but it is not contended that the defendant infringes the second claim. The first, third, and fourth claims are here involved. The first claim is for the angle door, when constructed and operated substantially as set forth, in combination with the lock or bolt which secures it so as to prevent entrance through it from within to the outside. The third claim is for the endless chain or rope, in combination with the levers by which the
partition doors are operated, when constructed and operated
32 substantially as and for the purposes set forth. The fourth

claim is for the combination and arrangement of the levers, bars, and bolts, or lugs connected with the cell doors, when operated from without the grating, substantially as and for the purposes set forth.

* * * * * * *

The patent law recognizes as patentable an improvement in any art or mechanical construction or combination which is useful to the public and not before known. To be patentable a thing must not only be new and useful, but must amount to an invention or discovery. Although the result is produced by a mechanism which combines old mechanical elements or powers without the use of any new element, the true question in such a case is whether the combination of elements by the patentee is new. If they have never been combined together in the manner stated in the patent, and if the combination is new and useful, not being the result of mere mechanical skill, but of invention, then it is patentable. Each and all of the separate parts of a combination may be old and well known. The combination may contain the lever, the pulley, the wheel, and other well-known and long-used devices which would not, separately, be patentable; nevertheless, if the combination is new and produces a new and useful result it—that is, the combination—is patentable. Almost all combination structures are made up of separate parts and elements which are old and well known, and if that fact alone would invalidate a patent some of the most valuable inventions of the present day would at once become the common property of the public and valueless to their owners. The
law does not encourage or sanction the defeat of combination
33 patents on the ground that the several parts are old, if the
combination is new and useful.

The patent here in question has been passed upon by the late circuit justice of this circuit, Justice Davis, in a suit at law like this, to recover damages for infringement. As appears from his charge to the jury, which we have before us, no combination was shown, as none is shown here, anticipating May's invention. In that case, as in this, the question of originality, novelty, and patentability arose upon the patent itself and the mechanical structure patented, and Judge Davis held the patent valid, and instructed the jury that the combination patented exhibited invention and was entitled to protection. That ruling, thus made in this circuit by my official superior, ought to be controlling here, and I regard it as controlling, the same patent being involved in both cases and it not appearing that anything materially different is shown here from what was shown there. Judge Davis says that the May patent is really for a method unknown before, of bolting prison doors without coming in contact with prisoners. "To do this in the way shown," he said, "is patentable, and he is to be considered as the original combiner of this mechanical arrangement so as to produce the intended result. In doing this he has used nothing new, nor was he required to do it. Bolts, bars, locks, levers, and pulleys are all old, but the patentee used them in such a way that the jailer can control the prisoners by working the doors while remaining away from the prisoners. It is the working of the doors so as to avoid the necessity of actual contact with the prisoners which is his invention. This is his idea as he has carried it into successful practice."

34 This was the view taken by Judge Davis in the Indiana case of this patent, and in that view I fully concur. The patentee was a pioneer in the field; his patent was an original one. He did not, so far as is known here, merely construct an improvement on a structure previously patented. As Judge Davis says, he was the original combiner of the various parts of his apparatus, arranging them so as to produce a new and useful result.

The claims of the patent are to be read in the light of and in connection with the specifications. This is an elementary principle in patent law; and so reading them—that is, reading them in the light of what was sought to be accomplished—it does not do to say that the mere connection of a lever with bars and bolts or the connection of a lever with an endless chain or the mere attachment of a lock to a door or the mere construction of a door of peculiar shape does not constitute invention. The adjustment of the apparatus, the relation of the different combinations to the jail or prison, the objects sought and the results attained are all to be considered, especially in a patent like this, original in its character, and therefore entitled to a broader construction than one which is for a mere improvement on something of the same nature which has been previously invented. This would be naturally and was undoubtedly the view taken of this patent by Judge Davis, and I think it the correct view. So the conclusion is that the patent in suit was valid, and that the combinations therein described were patentable.

35 All this it was perhaps unnecessary to say to you, because the only question it is necessary for you to consider is whether the structures used by the defendant county in its jail is an infringement on the May invention; but, in view of the discussion at the bar, I desired counsel to fully understand the view which the court takes of the patent and of the patentability of this invention. If, then, you find that in all or either of the claims here in question, namely, the first, third, and fourth, the defendant has been guilty of infringement as charged, then the plaintiff should have a verdict. If you find that neither of the claims were infringed, then the defendant should have your verdict. What constitutes an infringement in a case like this is so well defined in a charge of the court to a jury in a reported case I have before me that I read to you from the printed volume: "An infringement takes place whenever a party avails himself of the invention of the patentee without such variation as will constitute a new discovery. An infringement involves substantial identity, whether that identity is described by the terms, the same principle, the same *modus operandi*, or any other. It is a copy of the thing described in the specifications of the patentee, either without variation or with only such variations as are consistent with its being in substance the same thing. No certain, definite rule can be stated by which to determine unerringly in every case what will amount to substantial identity; the jury, guided

by general principles, must determine each case upon its own
36 circumstances. If, however, the invention of the patentee
be a machine or an improvement on a machine it will be infringed by a machine which incorporates in its structure and operation the substance of the invention—that is, by an arrangement of its mechanism which performs the same service or produces the same effect in the same or substantially the same way. The question is, Whether the given effect is produced substantially by the same mode of operation and the same combination of powers and devices in both machines? Mere colorable or evasive differences cannot defeat the right of the original inventor. The inquiry, therefore, should be whether the defendants' device is in substance and effect a colorable evasion of the plaintiff's contrivance, or whether it is really a new and substantially different thing. If the defendants have taken the same general plan and applied it for the same purpose and produced the same effect in substantially the same mode, although they have varied the form or construction in some respects merely, it will still be, substantially, in contemplation of the patent law, the same thing; otherwise it will not. Whether or not one machine is an infringement of another, therefore, does not necessarily depend upon whether the mechanical constructions are different; but the question is whether, whatever be the mechanical construction, the latter machine contains the means or combination found in the previous machine; whether, taking the structure as you find it, you see the new idea completely embodied in it. * * *

If the defendants have only varied their combination by em-
37 ploying well-known mechanical substitutes for some one or
more material elements or parts of the plaintiff's combination, then there is an infringement; for a mere known mechanical substitute for a thing for the purpose of determining the question in issue must be regarded as the thing itself. * * * When, in mechanics, one device does a particular thing or accomplishes a particular result every other device known and used in mechanics which skilful and experienced workmen know will produce the same result or do the same particular thing is a known mechanical substitute for the first device mentioned for doing the same thing or accomplishing the same result, although the first device may never have been detached from its work and the second one put in its place. It is sufficient to constitute known mechanical substitutes that when a skilful mechanic sees one device doing a particular thing that he knows the other devices, whose uses he is acquainted with, will do the same thing."

Now, within these definitions, does the structure used by the defendant infringe the May device? In their general scope and object they seem to be quite alike and are evidently intended to secure the same result. Do they differ essentially in their organization or mode of operation? The one is evidently equivalent to the other as producing the same result; but in this sense it is not material to consider the subject. The question is whether the defendant has used substantially the same means or, mechanically speaking, equivalent means to accomplish the same result. If it has it is an infringer; otherwise not; and whether it has or not is a 38 question for the jury to determine. As we have seen, a mechanical equivalent, as generally understood, is where one may be adopted instead of the other by a skilled mechanic accustomed to machinery, with a competent knowledge of mechanical powers. If such a man, seeing a new machine and having a full description of the thing invented, can, by examining it with care, see that the required thing can be done in a different mode and it is done in that different mode by the knowledge which he has of his business he has not produced a new invention nor one substantially differing from the original; but if the inventive faculties are exercised to produce the change, then he has a right to the benefits of whatever he thus invents. There must be invention involved in the change and not the mere skill of the workman, to avoid the consequences of an infringement. The question here is, Does the structure used by the defendant substantially embody May's mode of operation and thereby obtain the same kind of results as were reached by his invention? It is not necessary that the result should be precisely the same in degree, but it must be the same in kind. For instance, shutting one door instead of two is a difference in degree, but not in kind; the same function is performed. (Charge of Judge Davis.)

Now, keeping in mind that the May invention consists of certain mechanical means which enable the jailer from the moment he enters the outer door to control the prisoners by fastening the corridor doors while separated from them, the question is, Do the means employed by the defendant in its jail infringe them? Has the defendant used the plaintiff's invention or something sub- 39 stantially like it? Do the structures operate upon the same principle? If there are differences, are they or not mere differences in form, producing the same result? The plaintiff's invention secured to the inventor not only the particular means described in the patent, but all other mechanical contrivances which are equivalents. When these mechanical arrangements are thus compared and analyzed, if differences be found it is for you to determine whether these differences are substantial or are only formal and evasive, arising from employing in the defendant's jail in the place of those specific parts or devices of the May combination other known mechanical substitutes therefor. If substantial, then there is no infringement; but if merely formal or evasive and not substantial there is an infringement.

* * * * * * *

The undisputed evidence shows, I think, a fixed royalty of fifty dollars for each cell at which the plaintiff's device or the right to use it was sold by the patentee in his lifetime. In such case it is the ruling of the courts that such royalty constitutes the proper measure of damages. If, therefore, you find the plaintiff entitled to recover you will allow her damages at the sum of fifty dollars for each cell in the Fond du Lac jail on which the invention was used prior to October 4, 1880, and subsequent to October 4, 1873. If there were thirty-four cells upon which it was used the total amount would be seventeen hundred dollars; and if you find for the plaintiff you may allow her interest upon the gross sum at seven per cent. from September 29, 1885. * * *

40 Thereupon the defendant excepted to certain parts of the foregoing charge, as follows:

The defendant excepts to that part of the charge beginning: "The patent law recognizes as patentable an improvement in any art or mechanical construction or combination" and ending "The law does not encourage or sanction a defeat of combination patents upon the ground that several parts are old, if the combination is new and useful," upon the ground that the court did not specify from the language of the claim the elements which the patentee had put into his several combinations stated in his several claims.

The defendant further excepts to the same portion of the charge because the court did not submit it to the jury to say whether the elements specified in each several combination appeared together as required in a practical combination under the instructions of the court, or whether it was a mere aggregation.

The defendant further excepts to all that portion of the charge defining an infringement.

The defendant further excepts to that portion of the charge that related to damages, upon the ground that the court did not leave it to the jury to find a smaller amount of damages than the royalty of fifty dollars, which had been paid by other parties for a much longer use.

And because none of said several proceedings, documents, testimony of witnesses, objections to rulings, motions and exceptions, instructions prayed by defendant, and the charge as given by the court and exceptions of the defendant in relation thereto 41 appear of record, the judge of said court, before whom said action was tried, has settled the foregoing as a bill of exceptions in the cause, and hereby certifies that the same is a complete and full statement of all the evidence given in said cause material to the questions raised by said motions, objections, instructions, and exceptions, and has set his seal hereto as a bill of exceptions in said cause.

(Signed) CHAS. E. DYER, *Judge*. [SEAL.]

42 "EXHIBIT A."

No. 25662.

THE UNITED STATES OF AMERICA.

To all to whom these letters patent shall come:

Whereas Edwin May, of Indianapolis, Indiana, has alleged that he has invented a new and useful improvement in the construction of prisons, which he states has not been used before his application; has made oath that he is a citizen of the United States; that he does verily believe that he is the original and first inventor or discoverer of the said improvement, and that the same hath not, to the best of his knowledge and belief, been previously known or used; has paid into the Treasury of the United States the sum of thirty dollars, and presented a petition to the Commissioner of Patents signifying a desire of obtaining an exclusive property in the said improvement, and praying that a patent may be granted for that purpose:

These are, therefore, to grant, according to law, to the said Edwin May, his heirs, administrator, or assigns, for the term of fourteen years from the 4th day of October, one thousand eight hundred and fifty-nine, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used the said improvement, a description whereof is given in the words of the said Edwin May in the schedule hereunto annexed and is made a part of these presents.

In testimony whereof I have caused these letters to be made patent and the seal of the Patent Office has been hereunto affixed.

43 [SEAL.] Given under my hand, at the city of Washington, this fourth day of October, in the year of our Lord one thousand eight hundred and fifty-nine, and of the Independence of the United States of America the eighty-fourth.

JACOB THOMPSON,
Secretary of the Interior.
WM. D. BISHOP,
Commissioner of Patents.

To all whom it may concern:

Be it known that I, Edwin May, of Indianapolis, in the county of Marion and State of Indiana, have invented certain new and useful improvements in the construction and operation of prisons, of which the following is a full and exact description, reference being had to the accompanying drawings & the letters marked thereon.

Figure 1 is a perspective and figures 2, 3, 4, 5, 6, 7, 8 are sectional views showing the construction and general arrangement of the same.

A represents the side and end walls of the prison; B, the floor; C, the outside door; D, inside or angle door; E, moulding or hood over door C; F, the cells; G, the small door of the safe or box J; H, the crank which operates the drum (*p*); I, bolt or lock to the angle door D; *a*, a bar connected with the bolts (*s*), which are operated by the levers (*b*) for the purpose of fastening the cell doors (*j*); *c*, fulcrum of the lever (*b*); *d*, levers for operating the sliding doors 44 (1); *e*, wire rope or endless chain which operates the levers (*d*); *f*, hinge joints to levers (*d*); *g*, support of pulleys for chain or wire rope; *h*, pulleys over which the chain or wire rope (*e*) operates; *i*, the grated partition; *j*, cell doors; *k*, slide or groove for doors (1) to work in; *m*, rollers for sliding doors (1); *n*, guard or slide for levers (*d*); *o*, staple to padlock levers (*b*); *q*, pawl or catch to hold the drum (*p*) in place; *r*, rollers for bar (*d*) to work over.

The nature and extent of the improvement will be more readily understood by reference to the object sought, which is avoiding the necessity of actual contact with the prisoners, while the keeper has perfect knowledge and control of them, and preventing their escape by knocking down the keeper, which has often occurred where the common arrangement of prison's has been used. It is peculiarly adapted to county prisons and that portion of State prisons appropriated to solitary confinement.

The following is the manner of operating the same and managing the prisoners: The jailer, opening the outside door C, releases the edge of the small or safe door G, giving access to the crank H, which operates the doors (1) in the grated partition (*i*) by means of the endless chain or rope which passes around the drum (*p*) and is attached to the hinge or joint (*f*) of the lever (*d*). The angle door D is held by the bolt or lock I while the keeper is allowed to examine every part of the hall, which the peculiar shape of the angle door D allows. Should there be any prisoners in the first hall they
are ordered to retire through the doors (1) in the grated par-
45 tition (*i*). The doors (1) are then closed by operating the
crank H, as has been shown; the keeper, then unlocking,
passes through the angle door D into the first hall, being separated from the prisoners by the grating (*i*), through which he orders the prisoners each to his cell, and to close the door after him by operating the lever (*b*) the bars (*a*) are drawn, while the bolts S, being drawn over the doors, secure the same. He then passes in and locks the doors (*j*), whereby an iron grating is always kept between the keeper and the prisoners.

What I claim and desire to secure by letters patent is—

First. The angle door D, in combination with the safe lock or bolt I, when constructed and operated substantially as set forth.

Second. The safe J, containing the drum (*p*) and bolt I, and being held by the outer door C, when constructed and operated substantially as and for the purposes set forth.

Third. The endless chain or rope (*e*), in combination with the levers (*d*), when constructed and operated substantially as and for the purposes set forth.

Fourth. The combination and arrangement of the levers (*b*), bar (*a*), and bolts or lugs S, when operated from without the grating I, substantially as and for the purposes set forth.

EDWIN MAY.

Witnesses:
WILLIAM FINDLAY.
WILLIAM THOMAS, Jr.

(Here follow diagrams marked pp. 46 & 47.)

48

Schedule B.

Certificate of Extension.

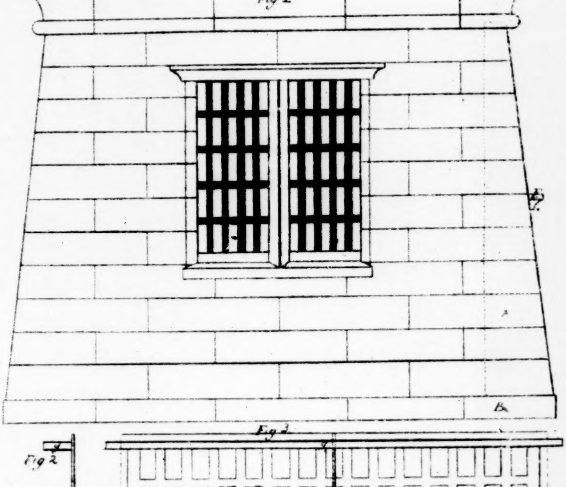
Whereas, upon the petition of Edwin May, of Indianapolis, Indiana, for the extension of the patent granted him October 4th, 1859, for an "improvement in the construction of prisons, the undersigned,

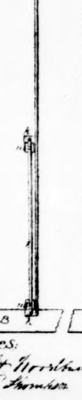
2 Sheets
Sheet 1

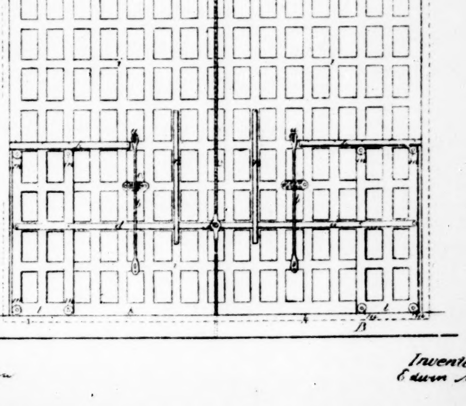
E. May.

Construction of Prisons.

No 25602.   Patented Oct 4. 1859.







No. 351
Co of Fond
du Lac.
v.
May
} p. 46

Witnesses:
James H. Morrison
Clinton Thomson

Inventor:
Edwin May

in accordance with the act of Congress approved the 8th day of July, 1870, entitled "An act to revise, consolidate, and amend the statutes relating to patents and copyrights," did, on this 4th day of October, 1873, decide that said patent ought to be extended:

Now, therefore, I, Mortimer D. Leggett, Commissioner of Patents, by virtue of the power vested in me by said act of Congress, do renew and extend the said patent, and certify that the same is hereby extended for the term of seven years from and after the expiration of the first term, viz., from the fourth day of October, 1873, which certificate, being duly entered of record in the Patent Office, said patent has now the same effect in law as though the same had been originally granted for the term of twenty-one years.

In testimony whereof I have caused the seal of the Patent Office to be hereunto affixed this fourth day of October, 1873, and [SEAL.] of the Independence of the United States the ninety-eighth.

M. D. LEGGETT,
Commissioner.

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EXHIBIT C.

Copy of Exemplification of Record from the Marion County Civil Circuit Court at Indianapolis, Indiana, upon which the Conveyance from Edwin May's Estate to Sarah May was Made.

STATE OF INDIANA, } *ss:*
Marion County,

Be it remembered that heretofore, to wit, on the 6th day of March, 1880, Edwin Forest May, of the county of Marion, in the State of Indiana, produced and filed in the office of the clerk of the circuit court of said county and State an affidavit showing the time of the death and the value of the personal estate of Edwin May, late of said county and State, deceased, as follows, to wit:

"STATE OF INDIANA, } *ss:*
Marion County,

Frank L. Bixby, being duly sworn before the clerk of the circuit court of the county aforesaid, upon oath says that Edwin May departed this life in said county, testate, as he believes, on the 27th day of February, 1880; that said decedent left a personal estate to be administered upon of the probable value, as he is informed and believes, of one thousand dollars; and further says not.

FRANK L. BIXBY.

Sworn to and subscribed before me this 6th day of March, 1880.
D. N. RANSDELL, *Clerk.*"

And thereupon said Edwin Forest May executed and filed in said clerk's office a bond, as executor of the last will and testament of said Edwin May, deceased, in the penalty of $2,000, with Ingram Fletcher and Thomas H. Spann, freeholders of said county, sureties therein, approved by such clerk; and, having taken, subscribed, and filed the oath required by law, letters testamentary upon said estate were duly granted and issued to said Edwin Forest May, which, with said bond and oath, were duly recorded in the book provided and kept for that purpose.

Exhibit D.

And be it further remembered that afterwards, to wit, at a regular term of the civil circuit court of the county of Marion and State of Indiana, held at the court-house, in the city of Indianapolis, Indiana, on the fifth day of June, 1880, the same being the 30th judicial day of the May term, 1880, of said court, before the Honorable Joshua G. Adams, sole judge of said court, the following proceedings were had in the matter of Edwin May's estate:

Comes now Edwin F. May, executor of the last will and testament of Edwin May, deceased, and files his report and resignation, showing that he is chargeable by the inventory filed herein in the sum of $3,428.86 and entitled to credits by property taken by the widow, $302.20; by difference in receipts from sale or personal property and inventory of $1,365.14, leaving in his hands $1,761.52; that he has paid out on account of his said trust the sum of $1,955.50, showing an overpayment by him of $193.98, which he asks may be made a charge against said estate; which report and resignation are as follows. (Omitted.)

And the court, having examined said report and being fully advised in the premises, does approve and confirm the same, and said overpayment by said executor is made a charge against said estate, to be paid him out of any moneys that may come into the hands of his successor herein that may be lawfully applied to the payment of said claim. The resignation of said executor is accepted, and he is hence discharged from the duties of his said trust.

50

Exhibit E.

And be it further remembered that afterwards, to wit, on the 7th day of June, A. D. 1880, George F. McGinnis, of the county of Marion and State of Indiana, executed and filed in the office of the clerk of the circuit court of said county and State his bond as administrator *de bonis non*, with the will annexed, of the estate of said Edwin May, deceased, in the penalty of $15,000.00, with Theo. P. Haughey surety thereon, approved by such clerk; and, having taken, subscribed, and filed the oath required by law, letters of administration *de bonis non*, with the will annexed, were duly granted and issued to him by such clerk, which, with said bond and oath, were duly recorded in the book kept for that purpose; which said bond, oath, and letters are in the words and figures following, to wit:

Know all men that we, George F. McGinnis and Theo. P. Haughey all inhabitants of the State of Indiana, are bound unto the State of

Indiana in the penal sum of fifteen thousand dollars; for the payment of which we jointly and severally bind ourselves, our heirs, executors, and administrators.

Sealed and dated the 7th day of June, 1880.

The condition of the above obligation is that if the above-bound George F. McGinnis shall faithfully discharge the duties of his trust as administrator *de bonis non* of the estate of Edwin May, deceased, according to law, then the above obligation is to be void; else to remain in full force.

GEORGE F. McGINNIS. [SEAL.]
THEO. P. HAUGHEY. [SEAL.]

Taken and approved by clerk this 7 day of June, 1880.
Attest: D. M. RANSDELL,
Clerk Marion Circuit Court.

STATE OF INDIANA, } *ss:*
Marion County, }

I, George F. McGinnis, swear that I will faithfully discharge the duties of my trust as administrator *de bonis non* of the estate of Edwin May, deceased, according to law, so help me God.

GEORGE F. McGINNIS.

Subscribed and sworn to before me this 7 day of June, 1880.

D. M. RANSDELL,
Clerk of Marion Circuit Court.

STATE OF INDIANA, } *ss:*
Marion County, }

Theo. P. Haughey, being duly sworn before the clerk of the circuit court of said county and State, upon oath depose- and say- that he is worth, over and above all indebtedness, the full amount of the penalty of the within bond in real estate situated in said State.

THEO. P. HAUGHEY.

Subscribed and sworn to before me, clerk as aforesaid, the 7th day of June, A. D. 1880.

D. M. RANSDELL, *Clerk.*

Letters of Administration.

STATE OF INDIANA, } *sct:*
Marion County, }

To whom these presents shall come, Greeting:

I, D. M. Ransdell, clerk of the Marion circuit court within and for the county of Marion and State of Indiana, do hereby certify that administration of the personal property of Edwin May, late of said county of Marion, deceased, is granted to George F. 51 McGinnis; and he, having qualified and given bond as such administrator *de bonis non*, etc., is duly authorized to take upon himself the administration of such estate according to law.

Witness my hand and the seal of said court, at the city of Indianapolis, this seventh day of June, 1880.

[SEAL.] D. M. RANSDELL,
Clerk of Marion Circuit Court, Ind.

EXHIBIT F.

And be it further remembered that afterwards, to wit, at a regular term of the civil circuit court of the county of Marion and State of Indiana aforesaid, held at the court-house, in the city of Indianapolis, State of Indiana, on the 31st day of December, 1881, being the 24th judicial day of the December term, 1880, of said court, before the Hon. Joshua G. Adams, sole judge of said court, the following further proceedings were had:

In the Matter of EDWIN MAY'S Estate.

Now comes George F. McGinnis, administrator of said estate of said decedent, and files his petition for the sale of certain patent right at private sale in the words and figures following, to wit:

Civil Circuit Court.

STATE OF INDIANA, } *sct:*
Marion County, }

In the Matter of the Estate of EDWIN MAY, Deceased.

George F. McGinnis, administrator of the estate of said decedent, showeth to the court that all the real and personal estate of said decedent which has come to the hands or knowledge of this administrator has been sold and the proceeds distributed under the direction and order of this honorable court, except the rights of said decedent in certain letters patent from the United States of America, which have not been disposed of; that there now offers a favorable opportunity for selling such rights; that the same are of little value, and that your petitioner believes that it is for the best interest of said estate to sell said rights at private sale without appraisement or advertisement, saving the cost thereof.

GEORGE F. McGINNIS.

Subscribed and sworn to this 31st day of December, 1881, before me—

[SEAL.] LEW WALLACE,
Notary Public.

EXHIBIT G.

And the court, having examined into such petition and heard the evidence, and being fully advised in the premises, finds that it is for the best interest of said estate to sell such rights at private sale without the delay and expense of appraisement and advertisements, and said administrator is now authorized and empowered by the court to sell said rights at private sale without advertisement or appraisement, and is ordered to report his doings at the next term of this court.

And time is given.

52 EXHIBIT I.

And be it further remembered that afterwards, to wit, at a further term of said Marion civil circuit court, held at the court-house aforesaid, on the 7th day of March, A. D. 1882, being the 20th judicial day of the February term, 1882, of said court, before the hon. judge last aforesaid, the following further proceedings were had in the matter of Edwin May's estate:

Comes now George F. McGinnes, administrator *de bonis non* of said estate, and files his report of the sale of certain letters patent heretofore ordered by the court, said report being in the words and figures following:

Marion Civil Circuit Court.

STATE OF INDIANA, } *sct:*
Marion County, }

In the Matter of the Estate of EDWIN MAY, Deceased, and Petition to Sell Certain Letters Patent.

George F. McGinnes, administrator *de bonis non* of the estate of said decedent, Edwin May, presents the following report of his doings in respect to the order heretofore entered by this court authorizing said administrator to sell at private sale the rights of said estate in certain letters patent: This administrator made diligent efforts to secure bids for such rights, and on the 19th day of January, A. D. 1882, Mrs. Sarah May did bid therefor the sum of fifteen dollars, and that being the best offer this administrator could procure, such rights were by this administrator sold to said Sarah May, and said Sarah May having paid said bid, this administrator executed to her a deed of assignment of such rights, which he now brings into court for approval.

Wherefore said administrator prays that said sale and said deed be approved and confirmed.

GEORGE F. McGINNIS,
Administrator.

And the court, having examined such report and being fully advised in the premises, ratifies and confirms said sale.

And said administrator also presents for the approval of the court his deed of assignment pursuant to such sale; and the court, having examined such deed, ratifies, confirms, and approves the same.

All of which is finally ordered, adjudged, and decreed by the court.

STATE OF INDIANA, } ss:
Marion County, }

I, Moses G. McLain, clerk of the circuit court within and for said county and State, being a court of record and having probate jurisdiction, do hereby certify that the above and foregoing contains a full, true, and correct transcript of so much of the proceedings had in the settlement of the estate of Edwin May, late of said county and State, deceased, as shows the application and appointment of Edwin Forest May as executor of the last will and testament of said decedent, with a copy of the affidavit showing the date of death and probable value of the estate of said decedent to be administered and a copy of the proceedings of the court approving the final report and accepting the resignation of said executor; also the appointment of George F. McGinnis as administrator *de bonis non*, with the will annexed, of said estate, together with a copy of the bond executed and filed by him and of the letters of administration granted and issued to him; also a true copy of the proceed-
53 ings had and orders made by said court relating to the sale of certain letters patent belonging to said estate, all of which fully appears from the records of said court in my custody and on file in my office.

[SEAL.] In testimony whereof I hereunto subscribe my name and affix the seal of said court this 30th day of December, 1884.

MOSES G. McLAIN,
Clerk Marion County Circuit.

STATE OF INDIANA, } ss:
Marion County, }

I, Alexander C. Ayres, sole judge of the circuit court of Marion county and judge of the nineteenth judicial circuit of the State of Indiana, do hereby certify that Marion county, in the State of Indiana, is comprised within and is a part of the said nineteenth judicial circuit of said State, and that the foregoing attestation and certificate of Moses G. McLain, clerk, are in due form of law, and that the said Moses G. McLain is and at the time of the making of said certificate and attestation was the clerk of the said circuit court of Marion county, in said State, and is and at said time was the proper officer to make such attestation and certificate, and that his signature thereto is genuine, and that as such clerk he is the sole custodian of the papers, documents, records, and seals pertaining to said court.

[SEAL.] Witness my hand and the seal of the said court, affixed at the city of Indianapolis, Indiana, this 30th day of December, 1884.

ALEXANDER C. AYRES,
Judge of the Circuit Court of Marion County, Indiana.

STATE OF INDIANA, } ss:
Marion County, }

I, Moses G. McLain, clerk of the circuit court of Marion county, in the State of Indiana, do hereby certify that Alexander C. Ayers, whose signature appears in the foregoing certificate, is and was at the time of signing said certificate the sole judge of said court, duly commissioned and qualified in accordance with the laws of the State of Indiana.

[SEAL.] In testimony whereof I have hereunto set my hand and affixed the seal of said court, at the city of Indianapolis, Indiana, this 30th day of December, A. D. 1884.

MOSES G. McLAIN,
Clerk of the Circuit Court of Marion County, Indiana.

54 EXHIBIT H.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE.

To all persons to whom these presents shall come, Greeting:

This is to certify that the annexed is a true copy from the records of this office of an instrument of writing executed by George F. McGinnes, administrator of the estate of Edwin May, deceased, March 6, 1882, and recorded in Liber Z 34, page 54; said record has been carefully compared with the original and is a correct transcript thereof.

[SEAL.] In testimony whereof I, M. V. Montgomery, Commissioner of Patents, have caused the seal of the Patent Office of the United States to be affixed this 13th day of March, in the year of our Lord one thousand eight hundred and eighty-six, and of the Independence of the United States the one hundred and tenth.

M. V. MONTGOMERY,
Commissioner.

Know all men by these presents that whereas Edwin May, late of Marion county, in the State of Indiana, deceased, did during his life obtain of the United States of America certain letters patent for inventions and discoveries, as follows:

First. Certain letters patent for an improvement in the construction of prisons, dated October 4th, 1859, and numbered 25662, and in the extension of said letters patent granted to said Edwin May, and dated October 4th, 1873.

Second. Certain letters patent for an improvement in the construction of prisons, dated December 27th, 1870, and numbered 110,483.

Third. Certain letters patent for an improvement in the construction of prison walls, dated June 28th, 1870, and numbered 104,865.

Fourth. Certain letters patent for an improved fire-proof building, dated May 4th, 1869, and numbered 89782.

Fifth. Certain letters patent for an improvement in fire-proof buildings, dated January 26th; 1869, and numbered 86312.

Sixth. Certain letters patent for an improvement in sheet-metal lath machine, dated April 13th, 1869, and numbered 88972.

And whereas said Edwin May having departed this life the sole owner of said letters patent, and I, George F. McGinnis, of Marion county, in the State of Indiana, having been by the Marion civil circuit court of said Marion county, Indiana, duly appointed administrator *de bonis non* of said estate of said decedent, did, on the 31st day of December, 1881, procure from said Marion civil circuit court an order of said court, duly entered — Order Book No. 56 of said court on, page 485, wherein said court did authorize, empower, and direct me, as such administrator, to sell at private sale all the right, title, interest, claim, and demand of said estate in, by, under, and through said letters patent and each of them ;

And whereas, in pursuance to such order, I did, on the 19th day of January, 1882, at private sale, sell all and singular the letters patent aforesaid and all the right, title, interest, claim, and demand of said estate in, to, by, under, and through the same to Sarah May, of the said Marion county, in the State of Indiana, for the sum of fifteen (15.00) dollars, that being the highest and best bid and offer for such rights: Now, therefore, to all whom it may concern, be it known that for and in consideration of the said sum of fifteen ($15.00) dollars to me in hand paid and in pursuance to the order and authority aforesaid I, the said George F. McGinnis, as administrator of the estate of said Edwin May, deceased, have sold, assigned, transferred, and set over, and do hereby sell, assign, transfer, and set over, unto the said Sarah May all the right, title, interest, claims, and demands whatsoever which the said estate of said Edwin May, deceased, has in, to, by, under, and through the said improvements and the letters patent and extensions thereof therefor aforesaid; the same to be held and enjoyed by the said Sarah May for her own use and behoof and for the use and behoof of her legal representatives to the full end of the term for which said letters patent and extensions thereof are or may be granted as fully and entirely as the same would have been held and enjoyed by said estate had this assignment and sale not been made and as by and under the order and authority aforesaid I, as such administrator, can or ought to grant, sell, and assign the same.

In testimony whereof I, George F. McGinnis, administrator of the estate of Edwin May, deceased, have hereunto set my hand and affixed my seal this 6th day of March, A. D. 1882.

GEORGE F. McGINNIS, [SEAL.]
Administrator of the Estate of Edwin May, Deceased.

In the presence of—
CHARLES PLESCHUEY.
JOHN SHARNE.

March 7th, 1882.—Examined and approved by the court.
J. G. ADAMS, *Judge.*

55 EXHIBIT J.

United States Circuit Court, Eastern District of Wisconsin.

SARAH MAY, Pl'ff.
v.
THE COUNTY OF FOND DU LAC, Def't.

It is stipulated that the device used in the Fond du Lac county jail for fastening the doors referred to in the complaint herein and claimed by the plaintiff to be an infringement of the May patent has been in use in said jail since 1869, but this stipulation is without prejudice to the plea of the statute of limitations; and it is further stipulated that the model of said jail showing such device, prepared by De Groat, Giddings & Lewis, of Fond du Lac, pursuant to an arrangement between the parties, is a correct representation of the device used in said jail for fastening the doors of the cells therein and of the angle observation door.

This stipulation is made to save the expense and trouble of calling witnesses to prove the facts herein agreed to.

This stipulation is without prejudice to the defendant's right to apply to the court for leave to use, for purposes of illustration and argument to the jury, the model now in its possession.

G. W. HAZELTON,
Pl'ff's Att'y.
F. F. DUFFY AND
SHEPARD & SHEPARD,
Def't's Att'ys.

56 EXHIBIT M.

UNITED STATES OF AMERICA, *District of Indiana:*

In the Circuit Court of the United States for the District of Indiana.
November Term for 1870.

Edwin May, a citizen of the State of Indiana, complains of the Board of County Commissioners of Johnson County, Indiana, a citizen of said State, in a plea of trespass on the case, for that whereas the said Edwin May, before and at the time of the making of the letters patent and of committing the grievance by the said defendants, as hereinafter mentioned, was the true and first inventor of a certain improvement in the construction of prisons, to wit, at said district of Indiana, and thereupon the United States of America heretofore, to wit, on the fourth day of October, in the year of our Lord one thousand eight hundred and fifty-nine, in said United States, by their letters patent, bearing date at the city of Washington the day and year aforesaid, under the seal of the Patent Office, and which said letters patent the said plaintiff now brings here into open court, reciting that whereas Edwin May, of Indianapolis, Indiana, has alleged that he has invented a new and useful improvement in the construction of prisons, which he states has not been known or used before his application, and has made oath that he is a citizen of

the United States; that he does verily believe that he is the original and first inventor or discoverer of the said improvement, and that the same hath not, to the best of his knowledge and belief, been previously known or used, and has paid into the Treasury of the United States the sum of thirty dollars and presented a petition to the Commis-
57 sioner of Patents signifying a desire of obtaining an exclusive property in the said improvement and praying that a patent may be granted for the purpose, and therefore the letters patent were granted according to law to the said Edwin May, his heirs, administrators, or assigns, for the term of fourteen years from the 4th day of October, one thousand eight hundred and fifty-nine, — the full and exclusive right and liberty of making, constructing, using, and vending to others to be used the said improvement, a description whereof is given in the schedule annexed and made a part of said letters patent, — reference thereunto being had will more fully and at large appear; and the said plaintiff further says that he, the said plaintiff, has always, from the time of making the said letters patent as aforesaid, made, used, and exercised the said invention to his great advantage and profit, to wit, at the district of Indiana aforesaid; yet the said defendant, well knowing the premises, but contriving and wrongfully intending to injure the said plaintiff and deprive him of the profits, benefits, and advantages which he might and otherwise would have derived and acquired from the making, using, exercising, and vending of the said invention, after the plaintiff had invented the said improvement, with full notice thereof and of the plaintiff's rights in the premises, and within the said term of years in the said letters patent mentioned, to wit, on the day and year last aforesaid and on different other days before the commencement of this suit, and within the United States of America, to wit, at the district of Indiana, unlawfully and unjustly and without leave or license and against the will of the
58 said plaintiff made or caused to be made an improvement in the construction of prisons, in imitation of the said invention of the said plaintiff aforesaid, in breach of the said letters patent and against the privileges so granted to the plaintiff aforesaid, whereby the said plaintiff has been and is greatly injured and deprived of a great part of the profits and advantages which he might or otherwise would have derived and acquired from the said invention, to wit, at the district of Indiana aforesaid.

2nd. And the said plaintiff further says that he, the said plaintiff, so being such inventor as aforesaid and the said letters patent having been so made as aforesaid, and the said invention having been a mode used and exercised as aforesaid by the said plaintiff as aforesaid, the said defendants well knowing the premises, but further contriving and intending, as aforesaid, after the making of the said letters patent mentioned, to wit, on the day and year last aforesaid and on several other days and times between that day and the day of the commencement of this suit, to wit, at the district of Indiana aforesaid, unlawfully and unjustly and without leave or license and against the will of the said plaintiff used and put in practice an improvement in the construction of prisons, in imitation of the invention of the said plaintiff, in breach of the said letters patent and against the privileges so granted to the said plaintiff and assigns as aforesaid, whereby the said plaintiff has been and is greatly injured and has lost and been deprived of divers great gains and profits which he might and otherwise would have derived and acquired from the said invention, to wit, at the district aforesaid.

59 3rd. And the said plaintiff further says that he, the said plaintiff, so being such inventor as aforesaid, and the said letters patent having been so made as aforesaid, and the said invention having been so made, used, and exercised by the said plaintiff as aforesaid, the said defendants, well knowing the premises, but further contriving and intending as aforesaid, after the plaintiff had invented the said improvement, with full notice thereof and of the plaintiff's rights in the premises, and within the said term of years in the said letters patent mentioned, to wit, on the day and year last aforesaid and on different other days and times between that day and the day of the commencement of this suit, to wit, at the district of Indiana, unlawfully and unjustly and without leave or license and against the will of the said plaintiff did imitate the said invention and did put in practice an improvement in the construction of prisons in breach of the said letters patent and against the privileges so granted to the plaintiff and his assigns as aforesaid, whereby the said plaintiff has been greatly injured, and has lost and been deprived of divers great gains and profits which he might and otherwise would have derived and acquired from the said invention, to wit, at the district aforesaid.

Wherefore the said plaintiff says that he is injured and sustained damages to the amount of one thousand dollars; wherefore he brings this suit.

NICHOL & JORDAN,
For Plaintiff.

60 In the United States Circuit Court.

EDWIN MAY
v.
THE BOARD OF COMMISSIONERS OF JOHNSON COUNTY.

And the said defendants, by M. M. Ray, their attorney, come and defend the wrong and injury when, &c., and say that they are not guilty of the said supposed grievances above laid to their charge or any or either of them or any part thereof, in manner or form as the plaintiff hath above complained against *him*, and of this the defendants put themselves upon the country, &c.

M. M. RAY,
Att'y for Defendants.

Circuit Court United States, District of Indiana.

EDWIN MAY
vs.
THE BOARD OF COMMISSIONERS OF JOHNSON COUNTY.

Nichol & Jordan, attorneys for pl'ff:

Take notice that the above-named defendant, on the trial of this cause, will give in evidence under the general issue and insist that in the year 1870 the defendants, as the Board of Commissioners of Johnson County, Indiana, caused a jail to be constructed at Franklin for the use of Johnson county, and in the prosecution of said work they let the iron work thereof to Haugh & Co., of the city of Indian-
apolis, and that prior to that time, to wit, on the 16th day of
61 June, 1868, one Isaac Hodson, a citizen of the United States,
had issued to him from and by the Patent Office of the United
States —, in due form of law, for a new and useful improvement in the construction of prisons and which improvement was novel and useful and of which said Hodson was the inventor and patentee and which was not an invasion or infringement of the plaintiff's patent, because the two patents are quite different from each other, as appears by reference to the original letters patent so issued to the said Hodson, which are referred to and made part of this notice. Defendants will also offer evidence and insist at the trial, 1st, that the plaintiff's patent is void, as attempting to patent a principle instead of an application of a principle; 2nd, that the same as an invention or improvement is neither novel or useful. The defendant will also show that the Board of Commissioners of Johnson County did not manufacture or use the plaintiff's supposed patent for any purpose of their own, but only permitted the improvement to be used and applied by said Haugh & Co., who contracted with them to do and complete the iron-work of said jail, the defendant not knowing that the plaintiff claimed any interest in the same, but supposed that said Haugh & Co. had good right and lawful authority to use the same. The plaintiff will also take notice that the defendant will offer in evidence and insist on the trial of this cause that the supposed invention and improvement in prisons used by said Haugh & Co. in the said jail was and is not an infringement of any patent claimed by the plaintiff, as set forth in his declaration, but that the same is constructed and used by said Hodson, Haugh & Co. and the defendant under, by virtue of, and in conformity with the said pat-
ent of the said Hodson, with the leave, license, and special
62 authority of the said Hodson, and that said Hodson's said
patent is novel and useful, and that he is the original in-
ventor of such improvement in prisons as his patent purports to be, and that the manufacture of the same and the use of the same by the said Hodson and Haugh & Co. and the suffering the same to be used in the jail of Johnson county by defendants was and is justified by the said patent of said Hodson, and that defendant in suffering the said supposed improvement to be used had no notice or knowledge that the plaintiff claimed or owned any interest therein, as pat-

entee or otherwise. For a more particular description of the patent of said Hodson the defendant refers to the patent claimed by and in the specifications, drawings, and exemplifications and letters patent now presented herewith.

M. M. RAY,
Att'y for Defendant.

In the Circuit Court of the United States, District of Indiana. May Term, 1872.

EDWIN MAY
vs.
THE BOARD OF COMMISSIONERS OF JOHNSON COUNTY.

Now, the said plaintiff, as to the second and third pleas by the said defendant above pleaded and each of them, saith that the same and each of them and the matter therein and — each of said pleas contained, as the same in the several pleas are above pleaded and set forth, are not sufficient nor is either of them sufficient in law to preclude the said plaintiff from having or maintaining his aforesaid action; wherefore the said plaintiff prays judgment of the said several pleas, &c.

And for the special cause of demurrer as to the said second
63 and third pleas the said plaintiff says that the said defendant
has not traversed or denied or attempted to put in issue any matter or thing in the said declaration, except what is traversed in the first plea by the said defendant above pleaded, nor has he introduced or attempted to introduce any new matter by way of demand; but the said pleas and each of them are argumentative and evasive; and for further special causes of demurrer as to the said second — third pleas, the said plaintiff says that said pleas and each of them amount to the general issue which is also pleaded in form by the said defendant in the first plea as above pleaded. This the plaintiff is ready to verify, &c.

Wherefore he prays judgment of said pleas, &c.

M. NICHOL,
McDONALD, BUTLER & McDONALD,
Att'ys for Pl'ff.

In the United States Circuit Court, Indiana.

EDWIN MAY
vs.
THE BOARD OF COMMISSIONERS OF JOHNSON COUNTY.

No. 1. And the said defendant, The Board of Commissioners of Johnson County, Indiana, by Hendricks, Hord & Hendricks and M. M. Ray, their attorneys, comes and defends the wrong and injury, when, &c., that they did not undertake and promise nor commit the grievance in manner and form as the plaintiff has above thereof complained against them, and of this they put themselves upon the country, &c.

No. 2. And for further and second pleas in this behalf the defendant- say*s* that the plaintiff ought not to recover against the defendants, because they say that the plaintiff's supposed patent is neither novel nor useful, and that the same was not when
64 patented, nor is it now, an art, machine, manufacture, or
composition of matter within the meaning of any act of Congress, and so was not patentable under any act of Congress, and that supposed invention, lock and machine, was known and in general use before the plaintiff's patent was issued, because the defendant says that before the plaintiff procured his patent, to wit, on the 28th day of January, 1856, one Edwin Kershaw had discovered and published the identical invention or improvement in the plaintiff's complaint mentioned, and did on the day and year aforesaid apply for and obtain letters patent thereon in the name of himself and Henry M. Hooper & Co., all of whom then were and still are of the city of Boston, State of Massachusetts, under the name and descriptions, improved cell lock, duly issued by the Government of the United States, and thereupon published, by the authority of the United States, in the regular Patent Office Reports for the year 1856, with a full description thereof, and fully illustrated by drawings published by authority of the United States in vol. No. 3 of the Patent Office Reports published in and for the year 1856, on page 89 thereof, which drawing is numbered 14178, and this description of said patented improvement is found on page 380 of the vol. No. 1 of the said Patent Office Reports of said year 1856. Wherefore the defendant says the supposed invention of the plaintiff was fully known and published by said Edwin Kershaw and Henry M. Hooper in the year 1856, in manner and form aforesaid, and therefore the defendant says the said supposed patent of the plaintiff is void for want of novelty; all of which defendant is ready to verify.

HENDRICKS, HORD & HENDRICKS AND
M. M. RAY, *Att'ys for Def't.*

65 No. 3. The defendant-, for further and third pleas, say*s* the plaintiff should not recover, because they say that as the board of commissioners of the said county of Johnson, at the town of Franklin, in the county of Johnson, they caused to be erected a county jail for said county, and that in the construction thereof they employed William Haugh & Co., of the city of Indianapolis, who were and are manufacturers of iron cells, crates, doors, locks, fastenings, and other devices for the security of prisoners in jails; that Haugh and Co. manufactured and put into said jail the necessary cells, crates, doors, and other fastenings, among which was the supposed lock and fastening claimed by said plaintiff to be an imitation and an infringement on his supposed patent, of the right to make, vend, and use which *this* defendant- had no knowledge nor did they assume to have any knowledge, but permitted the same Haugh & Co. to put the same in use in said jail as part of the whole job under said contract for the iron-work of said jail; that said lock claimed by the plaintiff to be an improvement in prisons is not the lock and improvements in prisons which the said Haugh & Co.

put in use in the said jail by permission of the defendants, but, on the contrary thereof, the same was an improvement which was patented to and secured to the said Haugh and Co by one Isaac Hodson, Esq., of the city of Indianapolis, Ind., and under a license and permission from the said Hodson the said Haugh & Co. had the right to manufacture, vend, and use, and who did manufacture, vend, and use, the same in the prosecution of their said business, and who did manufacture and place in the jail of said county the said improvement in prisons as aforesaid under his said contract as aforesaid, and at no other time or place or in any 66 other form or manner or in any other sense did the defendant manufacture, use, or caused to be manufactured or used the plaintiff's said supposed invention. The defendant further says that on the 10th day of June, 1868, the said Isaac Hodson having complied with all the requirements of the laws of Congress on the subject — procuring patents, did have granted him a patent, which was fully issued by that date letters patent and duly signed by the Secretary of the Interior of the United States of America, for an improvement in the construction of prisons, which is the same improvement, invention, and lock which the said Haugh & Co. put into the Johnson county jail as aforesaid and not the improvement, invention, or lock covered by the plaintiff's supposed patent, but covered by the said patent of the said Isaac Hodson, and the right to manufacture, vend, and use which was then and now secured to the said Haugh and Co. by grant and license, as and under which the defendant claims protection, which letters patent to the said Hodson the defendants now bring into court and make profert thereof; all of which facts herein pleaded this defendant is ready to verify as the court may direct.

HENDRICKS, HORD & HENDRICKS AND
M. M. RAY, *Att'ys for Def'ts.*

67 *Notice of Special Matter.*

The plaintiff will take notice that the defendant will introduce at and upon the trial of the above-entitled cause, by way of defense, that on the 16th day of June, 1868, the Government of the United States granted and issued letters patent to one Isaac Hodson, Esq., of the city of Indianapolis, Indiana, for an improvement in the construction of prisons; that said Hodson granted a license to manufacture, use, and vend the said patented improvement to one Haugh & Co., iron manufacturers and manufacturers of jails, cells, crates, doors, locks, &c., for prisons; that defendants, as commissioners of Johnson county, Indiana, caused to be constructed a jail for said county in the year 1870, at the expense of said county, and that as such commissioners they contracted with said Haugh & Co. to put in said jail all iron cells, crates, doors, locks, &c., and that in pursuance of said contract the said Haugh and Co. put into the said jail the said improvement in the construction of prisons, which consisted of a patent lock, and which the defendant will insist is not the same lock and improvement covered by the supposed letters patent of the plaintiff, but is covered strictly by the letters patent of the said Isaac Hodson, and that this is the same use complained of by the plaintiff, and that therefore the defendant is not guilty of infringement of plaintiff's supposed patent; all of which will be given on the trial under the general issue, and that the defendant will produce on the trial the said letters patent and will prove the license to use the same as aforesaid.

HENDRICKS, HORD & HENDRICKS AND
M. M. RAY, *Att'ys for Def'ts.*

68 No. 4. And for the fourth plea the defendant- say the plaintiff ought not to maintain said action against them, because they say that the Board of Commissioners of Johnson County is a political corporation and was such at the time of committing the grievance in the declaration mentioned, with certain legislative and administrative powers and duties under the laws of the State of Indiana, constituting one of the geographical and administrative subdivisions of the State of Indiana, and so not liable, because as such corporation the defendant caused a new jail to be built for Johnson county, Indiana, by contract with Haugh & Co., and in the construction of the iron-work in the interior thereof the said Haugh & Co. put in use the said patent of the plaintiff.

HENDRICKS, HORD & HENDRICKS AND
M. M. RAY, *Att'ys for Def'ts.*

EDWIN MAY
v.
THE COMMISSIONERS OF JOHNSON COUNTY.

The defendant-, by Hendricks & Ray, their attorneys, moves the court to set aside the verdict of the jury herein and to grant defendant- a new trial herein for the following causes and reasons, to wit:

1st. The court erred in overruling the plaintiff's demurrer to the defendants' several pleas as it related to the plaintiff's declaration, as to which declaration the said demurrer should have been sustained, and because the court sustained the said demurrer to the
69 fourth plea pleaded by the defendant-.

2nd. The court erred in giving to the jury the instructions numbered 1, 2, 3, 4, 5, 6, and 7 of the written charge of the court.

HENDRICKS & RAY.

EDWIN MAY
v.
THE BOARD OF COMMISSIONERS OF JOHNSON COUNTY.

The defendant-, by Hendricks and Ray, their attorneys, moves the court, this court having overruled their motion for a new trial herein, to arrest the judgment on the verdict herein, and for cause say that the declaration in this cause does not state a cause of action against the defendant, the said defendant being a political corporation only and there being no law shown whereby the board of county commissioners of Johnson county are made liable for a tort for the infringement of a patent right; therefore the defendant moves in arrest of the judgment of the court on said verdict.

HENDRICKS & RAY,
Att'ys for the Def'ts.

70 In the United States Circuit Court for the District of Indiana.
May Term, 1872.

EDWIN MAY
v.
THE BOARD OF COMMISSIONERS OF JOHNSON COUNTY.

Be it remembered that in making the issue in this cause the defendant filed the general issue and notice of special matter under the same, and also three special pleas, to each of which the plaintiff demurred on the ground that neither of them constituted any bar to the plaintiff's suit; and thereupon the defendant insisted upon and pointed out that the plaintiff's declaration was insufficient and did not show a sufficient cause of action against the defendant as a corporation, and therefore insisted that this court should sustain said demurrer to the plaintiff's declaration, but the court overruled said demurrer as to the fourth plea of the defendant, to which ruling of the court the defendant excepted at the time; and be it remembered that on the trial of the cause the plaintiff introduced his letters patent and other evidence tending to show that the defendant, by the use of a certain iron jail fastening in the Johnson county jail, had infringed the plaintiff's patent. Defendants, on their part, introduced letters patent of one Isaac Hodson, under whose patent the defendant had constructed and used said jail fastening, and also other evidence tending to prove that the said Hodson patent was not an infringement on the plaintiff's patent. The court instructed the jury as follows, to wit:

(Here insert instructions.)

71 To the giving of each of which instructions numbered 1, 2, 3, 4, 5, 6, 7, the defendant at the proper time excepted.

And be it further remembered that after deliberation the jury returned into open court a verdict for the plaintiff, assessing his damages at four hundred dollars; and thereupon the defendant moved the court for a new trial herein and filed the following written causes therefor, to wit:

(Here insert causes for a new trial.)

And thereupon the court overruled the defendant's motion for a new trial; to which ruling of the court the defendant at that time excepted; and thereupon the defendant moves the court in arrest of judgment upon the verdict of the jury and filed the following causes therefor, to wit:

(Here insert causes.)

Which motion in arrest of judgment was overruled by the court, and the defendant then and there excepted to the ruling of the court, and thereupon rendered judgment of the said verdict; to which ruling of the court in rendering judgment on the said verdict the defendant excepts, and prays the court to sign and seal this his bill of exceptions, which is accordingly done.

DAVID DAVIS.

72 EDWIN MAY
v.
THE BOARD OF COMMISSIONERS OF JOHNSON COUNTY.

In the U. S. Circuit Court. May Term, 1872.

Comes now the plaintiff and moves the court to strike out the special matter set out in the notice attached to the plea of the said defendant pleaded, because he says that said alleged special matter does not amount to any defense to his aforesaid action.

NICHOL, McDONALD,
BUTLER & McDONALD,
Att'ys for Pl'ff.

In the U. S. Circuit Court. May Term.

EDWIN MAY
v.
THE BOARD OF COMMISSIONERS OF JOHNSON COUNTY.

Comes now the plaintiff and, for reply to the second plea, — the said defendants, pleaded *prelude tum*, because he says that the said defendants, of their own wrong and without any of the causes in said plea mentioned, committed the grievances complained of in his said declaration mentioned, and that he prays may be inquired of by the country, &c.

NICHOL, McDONALD & McDONALD,
Att'ys for Pl'ff.

73 In the Circuit Court of the United States for the District of Indiana. May Term, 1872.

JUNE 1, 1872.

Before the Honorable David Davis, judge.

EDWIN MAY
v.
THE BOARD OF COMMISSIONERS OF JOHNSON COUNTY.

Come again the parties, by their respective attorneys, and the jury heretofore empanneled and sworn herein also comes and return into court the verdict following:

We, the jury, find for the plaintiff and assess his damages at the sum of four hundred dollars.

In the Circuit Court of the United States for the District of Indiana.
May Term, 1872.

JUNE 5, 1872.

Before the Honorable David Davis, judge.

EDWIN MAY
v.
THE BOARD OF COMMISSIONERS OF JOHNSON COUNTY.

Comes now the plaintiff, by counsel, and moves the court for judgment upon the verdict heretofore rendered herein. It is therefore considered by the court that the plaintiff do recover of the defendant the said sum of four hundred dollars, together with his costs and charges in *their* behalf laid out and expended, taxed at ——.

74 The charge of Judge David Davis, of the United States Supreme Court, to the jury on the May patent, in the case of Edwin May *vs.* The Commissioners of Johnson County, Indiana, in the circuit court of the United States for the district of Indiana, in 1872.

The laws of Congress not only secure a party for a limited term of years a property right in a new and useful invention, — if the subject-matter of a patent possesses the requisites of novelty and utility it is protected against the encroachments of any society, and no one has a right to use it without paying for it. By a natural law the creations of a man's genius are as much his own property as the house or land he may purchase with money he has earned; and the patent law, in order to encourage the inventive faculty, recognizes as patentable an improvement in any art which is useful to the public and not before known, although the result is produced by a mechanism which combines old mechanical powers without the use of any new element. The true question in such a case is whether the combination of materials by the patentee is new. If they have never been combined together in the manner stated in the patent, but the combination is new, then the invention of the combination is patentable. So far as the evidence goes, it does not appear that any such combination was known or in use before May's invention. The jury have therefore only to consider whether Hodson's structure is an infringement on May's. Hodson's structure seeks to accomplish the same result as May's.
75 Both construct prisons so as to avoid the necessity of actual contact with the prisoners, while the keeper can observe their movements and control them. The utility of such an invention commends itself to the common mind, and does not need to be enlarged upon. To construct a jail so that prisoners can be safely kept and their movements controlled and the jailer secured from violence is a beneficial object. Does Hodson's structure infringe on May's? In their scope and object they are alike and evidently intended to secure the same results. Do they differ essentially in their organization or mode of operation? The one is evidently

equivalent to the other as producing the same result; but in this sense it is not material to consider the subject. The main question is, Whether Hobson has used substantially the same means, or, mechanically speaking, equivalent means to accomplish the same result? If he has, he is an infringer; otherwise, not; and whether he has or not is a question for the jury to determine. A mechanical equivalent, as generally understood, is when one may be adopted instead of the other by a skilled mechanic accustomed to machinery and with a competent knowledge of mechanical powers. If such a man, seeing a new machine and having a full description of the thing invented, can by sitting down and examining it with care see that the required thing can be done in a different mode and it is done in that different mode by the knowledge which he has of his business, he has not produced a new invention nor one substantially differing from the original; but if the inven-
76 tive faculties are exercised to produce the change, then he has a right to the benefit of whatever he thus invents. There must be mind and inventive genius involved in the change, and not mere skill of the workman, to avoid the consequences of an infringement. To constitute an infringement the thing used by the defendant must be such as substantially to embody the plaintiff's mode of operation, and thereby obtain the same kind of result as was reached by his invention. It is not necessary that the result should be precisely the same in degree, but it must be the same in kind. For instance, the shutting of one door instead of two is a difference in degree but not in kind—the same function is performed. Keeping these general principles in mind, I hope you will find no difficulty in applying them to the present case. May's patent is really for a method unknown before, of bolting prison doors without coming in contact with prisoners by a mechanical arrangement. To do this way is patentable, and he is to be considered as the original combiner of this mechanical arrangement so as to produce the intended result. In doing this he has used nothing new, nor is he required to do it. Bolts, bars, locks, levers, and pulleys are all old, but May has used them in such a way that the jailer can control the prisoners by working the doors while remaining away from the prisoners. It is the working of the doors so as to avoid the necessity of actual contact with the prisoners which is the invention of May's. This is his idea as he has carried it into successful practice. He is protected by law and should be. If it were otherwise there would be no encouragement to inventive genius. Keeping in mind that May's invention is the ability of the jailer, from the moment
77 he enters the outer door, to control the prisoners by bolting the doors while separated from them, the question arises, Does Hodson's apparatus infringe it? The difference between the two machines which it is important for you to notice consists in the different means used to fasten the doors. In both machines the apparatus used is to fasten the doors so as to control the prisoners without being under any apprehension from them. May complains that Hodson has appropriated his purpose and arranged his machinery on the same principles, although the form has varied. The ques-

tion of infringement is one for the jury. The true point is, Have the defendants used the invention of the plaintiff or something substantially like it? Do the two structures operate upon the same principles? Are they substantially the same? Did it require any invention to substitute the pulley for the lever or to fasten the first door horizontally instead of perpendicularly? If it did not, they are mere change of forms to produce the same result, and the party using them in that way is an infringer. The operation of pulleys and levers are as old as society. Suppose a skilled mechanic should see May's invention, would he not at once know that the lever power in the pulley could serve the same purpose as the lever power in the lever and endless chain? This is a question for your determination. May's invention secured to him not only the means, but all other mechanical contrivances which are equivalent. It is well known to all intelligent men that the pulleys and weight can be used to produce the same result as the lever and bar. Did it require
78 any exercise of invention to substitute the pulley for the lever or the bolt horizontal for the bolt perpendicular? Would or not any good mechanic at once see that their substitution could be used to produce the same effect? If so, Hodson has perpetrated May's invention and must respond in damages. It is for you, from the evidence, to say whether he has or not; you have heard the evidence and must decide what witnesses to believe or disbelieve. I regret that the witnesses in this case have not by their opinions on this subject been able to lighten your labors; but I think, after all, the case will not give you a great deal of trouble. If you find for the plaintiff you will find four hundred dollars.

UNITED STATES OF AMERICA, } *ss:*
District of Indiana, }

I, Noble C. Butler, clerk of the circuit court of the United States for the district of Indiana, do hereby certify that the foregoing is a full, true, and complete transcript of the record in the cause of Edwin May *vs.* The Board of Commissioners of Johnson County, Indiana, in said court as fully as the same appears of record and remains on file in my office.

Witness my hand and the seal of said court, at Indianapolis, in said district, this 23rd day of December, A. D. 1886.

[L. S.] NOBLE C. BUTLER, *Clerk.*

79 DISTRICT OF INDIANA:

I, William A. Woods, judge of the district court of the United States for said district, do certify that at the date of the foregoing certificate Noble C. Butler was and now is the clerk of the circuit court of the United States for said district, and that his attestation aforesaid is in due form of law.

Witness my hand this 23rd day of December, 1886.

WILLIAM A. WOODS, *Judge.*

80 July 24, 1886.—This day came the defendant, by its attorneys, and filed its motion for a new trial on the ground of

newly discovered evidence, and same day affidavits on behalf of plaintiff in opposition to said motion filed.

August 9, 1886.—On reading the affidavits and exhibits filed by the defendant in support of the motion for a new trial on the ground of newly discovered evidence and the counter-affidavits filed by the plaintiff it is ordered that said motion be orally argued before the court on the first day of the October term, 1886.

October 8, 1886.—This day the motion of the defendant for a new trial on the ground of newly discovered evidence came on to be heard, and was argued by Mr. Shepard in favor of the same and by Messrs. Burch and Hazelton in opposition, on behalf of the plaintiff, and submitted, when the court took the same under consideration.

October 11, 1886.—This day came the parties, by their counsel, and, on consideration of the motion of the defendant for a new trial on the ground of newly discovered evidence and the arguments of counsel thereon, it is ordered by the court that said motion be, and hereby is, overruled.

81 June 23, 1887.—This day came the defendant and filed its bond in the sum of four thousand dollars, with John Bell and S. B. Stanchfield as sureties, conditioned that said defendant shall prosecute its writ of error to effect and answer all costs and damages if it shall fail to make good its plea, which bond is approved by Hon. John M. Harlan, associate justice of the Supreme Court of the United States assigned to this circuit, as a supersedeas, and is as follows:

Supersedeas Bond.

Supreme Court of the United States.

THE COUNTY OF FOND DU LAC, Plaintiff in Error,
vs.
SARAH MAY, Defendant in Error.

Know all men by these presents that we, The County of Fond du Lac, John Bell, and S. B. Stanchfield, of the county of Fond du Lac, in the eastern district of Wisconsin, are held and firmly bound unto Sarah May, of the city of Grand Rapids, in the county of Kent, in the State of Michigan, in the sum of four thousand dollars ($4,000), to be paid to the said Sarah May, her executors or administrators; to which payment, well and truly to be made, we bind ourselves and each of us, jointly and severally, and our and each of our successors, heirs, executors, and administrators, firmly by these presents.

Sealed with our seals. Dated this 29th day of April, 1887.

82 Whereas the above-named The County of Fond du Lac hath prosecuted a writ of error to the Supreme Court of the United States to reverse the judgment rendered in the above-entitled action by the circuit court of the United States for the eastern district of Wisconsin on the 15th day of June, 1886, for the sum of eighteen hundred sixty-six dollars and thirty-nine cents ($1,866.39) in behalf of said Sarah May, defendant in error, and against said The County of Fond du Lac, plaintiff in error:

Now, therefore, the condition of this obligation is such that if the above-named plaintiff in error, The County of Fond du Lac, shall prosecute its said writ of error to effect and answer all costs and damages if it shall fail to make good its plea, then this obligation shall be void; otherwise to remain in full force and virtue.

THE COUNTY OF FOND DU LAC, [L. S.]
By MARK CRAIN, *County Clerk.*
JOHN BELL. [L. S.]
S. B. STANCHFIELD. [L. S.]

Sealed and delivered in presence of—
F. F. DUFFY.
J. H. McCRARY.

STATE OF WISCONSIN,
Eastern District of Wisconsin, County of Fond du Lac, } *ss:*

83 John Bell and S. B. Stanchfield, being each duly and severally sworn, depose and say and each for himself, respectively, deposes and says that he is a resident and citizen of said State, district, and county; that he executed the foregoing bond as one of the sureties therein, and that he is worth the sum of two thousand dollars in property within said State, district, and county not exempt from execution and over and above all his debts, liabilities, and obligations.

JOHN BELL.
S. B. STANCHFIELD.

Subscribed and sworn to before me this April 29, 1887.
F. F. DUFFY,
[SEAL.] *Notary Public.*

Endorsed as follows: This bond is approved, to operate as a supersedeas, this June 23, '87. John M. Harlan, justice Sup. C't U. S.

Whereupon a writ of error and citation issued and a copy of said writ of error lodged for the defendant in error.

84 UNITED STATES OF AMERICA, *ss:*

Seal U. S. Circuit Court, Eastern District Wisconsin.

The President of the United States of America to the judges of the circuit court of the United States of America for the eastern district of Wisconsin, Greeting:

Because in the record and proceedings, as also in the rendition of a judgment in a plea which is in the said circuit court of the United States of America for the eastern district of Wisconsin, before you, between Sarah May, plaintiff, and The County of Fond du Lac, defendant, a manifest error hath happened, to the great damage of the said The County of Fond du Lac, as by the complaint appears, and, it being fit that the error, if any there hath been, should be duly corrected and full and speedy justice done to the parties aforesaid in this behalf, you are hereby commanded, if judgment be therein given, that then, under your seal, distinctly and openly, you send the record and proceedings aforesaid, with all things concerning the same, to the Supreme Court of the United States, together with this writ, so that you have the same at Washington on the second Monday of October next, in the Supreme Court to be then and there held, that, the record and proceedings aforesaid being inspected, the said Supreme Court may cause further to be done therein to correct that error that of right and according to law and custom of the United States should be done.

Witness the Honorable Morrison R. Waite, Chief Justice of the said Supreme Court of the United States, this 23rd day of June, in the year of our Lord one thousand eight hundred and eighty-seven, and of the Independence of the United States the 111th.

EDWARD KURTZ,
Clerk U. S. Circuit Court, Eastern Dist. of Wisconsin.

[Endorsed:] Filed June 23, 1887. Edw. Kurtz, clerk.

85 UNITED STATES OF AMERICA, *Eastern District of Wisconsin,* } *ss:*

I, Edward Kurtz, clerk of the circuit court of the United States of America for the eastern district of Wisconsin, do hereby certify that I have compared the writings annexed to this certificate with their originals now on file and remaining of record in my office, and that they are true copies of such originals and correct transcripts therefrom, being a transcript of the record in the case of Sarah May *vs.* The County of Fond du Lac.

In testimony whereof I have hereunto set my hand and duly affixed the seal of the said court, at the city of Milwaukee, in said district, this sixth day of July, in the year of our Lord one thousand eight hundred and eighty-seven, and of the Independence of the United States the 112th.

Seal U. S. Circuit Court, Eastern District Wisconsin.

EDWARD KURTZ, *Clerk.*

86 UNITED STATES OF AMERICA, *ss:*

To Sarah May, Greeting:

[SEAL.] You are hereby cited and admonished to be and appear at a Supreme Court of the United States, to be holden at Washington on the second Monday of October next, pursuant to a writ of error filed in the clerk's office of the circuit court of the United States for the eastern district of Wisconsin, wherein The County of Fond du Lac is plaintiff in error and you are defendant in error, to show cause, if any there be, why the judgment in the said writ of error mentioned should not be corrected and speedy justice done to the parties in that behalf.

Witness the Honorable John M. Harlan, associate justice of the Supreme Court of the United States assigned to the seventh circuit, at the city of Milwaukee, this 23rd day of June, A. D. 1887, and of the Independence of the United States the 111th.

JOHN M. HARLAN,
Justice Supreme Court U. S.

I admit service of above citation this 30th day of June, A. D. 1887.

G. W. HAZELTON,
Att'y for Pl'tff.

Endorsed on cover: E. Wisconsin C. C. U. S. No. 351. The County of Fond du Lac, plaintiff in error, *vs.* Sarah May. Filed July 14, 1887.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1890.

No. 61.

THE COUNTY OF FOND DU LAC,
Plaintiff in Error,

vs.

SARAH MAY,

IN ERROR TO THE CIRCUIT COURT OF THE UNITED STATES FOR THE EASTERN DISTRICT OF WISCONSIN.

BRIEF FOR PLAINTIFF IN ERROR.

CHARLES E. SHEPARD,
Of Counsel for Plaintiff in Error.

J. H. McCrory,
District Attorney,
and Attorney for Plaintiff in Error.

SUPREME COURT OF THE UNITED STATES.

THE COUNTY OF FOND DU LAC,
Plaintiff in Error,
vs.
SARAH MAY,
Defendant in Error.

THE STATEMENT OF FACTS.

The County of Fond du Lac, Wisconsin, defendant below, brings this writ of error to the Circuit Court of the United States for the Eastern District of Wisconsin, to reverse a judgment rendered on a verdict in favor of Sarah May.

The action was begun on September 28, 1885, to recover damages for an infringement of letters patent of the United States, dated October 4th, 1859, and numbered 25662, issued to Edwin May, the alleged inventor, for "improvements in the construction of prisons."

The complaint sets forth the following facts as constituting the alleged cause of action sued on:

The invention of a new and useful apparatus, described in the letters patent by Edwin May, which was not in public use or on sale over two years before his application for the patent;

The due issue of letters patent for said invention to Edwin May, on October 4th, 1859, for the term of fourteen years and a due extension of said letters patent for seven years longer, or until October 5th, 1880;

The death of Edwin May, in the county of Marion, Indiana, on February 27, 1880, he being then the owner of all rights under said letters patent;

The due appointment of Edwin Forrest May as executor of Edwin May, on March 6, 1880, by the circuit court of Marion County, having jurisdiction in that behalf and his acceptance;

The resignation of said Edwin Forrest May as such executor, and the due succession by appointment and acceptance, of George T. McGinnis, as administrator *de bonis non* of, &c., of Edwin May, deceased, on June 7, 1880;

The entry of an order by said Marion county Circuit Court, on December 30, 1880, at the instance of said administrator, directing him "to sell all the right, title and interest, claim and demand of said estate, in, by, under and through said letters patent and the extension thereof," and his sale to the plaintiff, on March 6, 1882, and pursuant to the order, of "all the right, title, claim and demand of said estate of said deceased,*including all rights of action and claims for damages of every kind and description which said estate had by reason of said patent and said extension;*"

The present ownership by the plaintiff of the letters patent and extension, and of all rights of action thereunder:

Infringement by the defendant, a corporation duly created under and by virtue of the laws of the state of Wisconsin, of the letters patent on and between October 4, 1873 and October 4, 1880—that is, within the term of the extension—to the plaintiff's damage in $3,000.

Record pp. 3-5.

The defendant put in issue every fact above stated, except that of the defendant's corporate character; and gave notice of prior knowledge and prior use of the alleged invention. The Wisconsin statute of limitation, §4222 R. S. of Wis., 1878, was also pleaded.

Record, pp. 5-7.

The trial before the Hon. Charles E. Dyer, then district judge of said district, and a jury occurred on May 13-15, 1886.

The evidence for the plaintiff consisted of the letters patent, the certificate of extension, a series of documents showing the proceedings in the Marion County Circuit Court, a model of a jail built according to the patent in suit, a model of the defendant's county jail, showing certain parts of its contrivances for locking cell doors somewhat resembling the illustrations and specifications of the patent, evidence of actual use of those contrivances, and the testimony of an expert who gave it as his opinion that the first, third and fourth claims of the patent were thereby infringed.

Record pp. 11-14.

The detailed discussion of the patented contrivance and of the plaintiff's title and defendant's liability we defer to a later part of our brief. But a summary and explanation of the letters patent in question is proper at this point, and it will be made by the aid of the illustrations bound between pages 24 and 25 of the printed Record.

The text of the specifications is found at pages 23 and 24 of the printed Record.

The objects of the patentee were two—safe observation of prisoners while out of their cells but within the outer inclosure of the jail, and a safe mode of locking them in their cells without need or risk of personal contact.

These objects he sought to attain by three separate but allied contrivances, which are the bases of the four claims of the patent.

Proceeding inwards from the outside of the jail, these three contrivances are:

1. An "angle door" D, built with a very obtuse perpendicular angle, in the middle line of the door, projecting inward, and a safe or box J, containing a drum *p*, operated by a crank H, and a bolt or lock I to the angle door. The entire scope and operation of this contrivance as related to the first claim, and explained in the specification is that the jailor, opening the extreme outer door of the jail, gains access to the angle door, and there looking through its grated bars, from the "coign of vantage" which the angle affords, while the lock I securely holds the angle door, inspects the interior of the prison, observes the prisoners and orders them to retire behind the corridor or partition doors *l*. These partitions are grated, and separate an outer hall or space from corridors running beside the tiers of cells.

2. When the prisoners are thus driven by the word of command beyond the corridor doors, the next step is to open the box J, (opening on the space between the outer door and the angle door) and operate by the crank H the drum *p*, carrying the endless chain or rope *e*, which by pulleys, levers and hinges opens or shuts the partition doors *l*. These doors being closed while the jailer is still at his post of observation outside of the angle door, he can then open the angle door and advance into the inner hall. The mechanism and operation thus explained afford the basis for the second and third claims.

3. The jailer then, through the grated corridor partition and door, which are between him and the prisoners, orders each prisoner to retire to his cell and to close the cell-door after him. The jailer then by the lever *b* draws the bar *a*, and the bar thus carries the bolts or lugs S over the corners of the cell-doors, and thereby fastens them. He then advances into the corridor and, if

he chooses, further secures the cell-doors by ordinary locks on them This mechanism is the basis of the fourth claim.

Record pp. 23–24

The four claims are these:

First. The angle-door, D, in combination with the safe lock or bolt I, when constructed and operated substantially as set forth.

Second. The safe J, containing the drum *p* and bolt I, and being held by the outer door C, when constructed and operated substantially as and for the purposes set forth.

Third. The endless chain or rope S, in combination with the levers *d*, when constructed and operated substantially as and for the purposes set forth.

Fourth. The combination and arrangement of the levers *b*, bar *a* and bolts or lugs S, when operated from without the grating I, substantially as and for the purposes set forth.

Record p. 24.

The letters patent and the extension thereof, when offered, were severally objected to on the grounds that upon the face of the specifications and claim they are not for a novel or an operative combination, and are invalid, and that this action was not brought within the time required by law, after the expiration of the letters patent.

Record, p. 11.

The documents proving the proceedings in the Circuit Court of Marion County, Indiana, about the estate of Edwin May, deceased, and the sale of the letters patent, when offered were severally objected to, on the grounds that they were singly or collectively immaterial and incompetent, and did not tend to vest any title to the cause of action sued on in the plaintiff, and that the jurisdiction of said Circuit Court of Marion county was not shown.

Record, pp. 11–12.

The documents in question are found at pages 25-32 of the Record. In her testimony to prove use of the contrivances in defendant's jail which are shown in the model, Exhibit L, the plaintiff sought to prove that those contrivances had been in actual use in said jail since 1869.

The defendant objected on the ground that the statute of limitations of Wisconsin (subdivisions 3, 4 and 5 of section 4222 of the Revised Statutes of Wisconsin of 1878), had run upon the alleged cause of action as to infringement prior to September 29, 1879, which was six years before this action was begun; and it requested the Court to limit the proof of such use to that which has occurred since September 28, 1879.

Record, p. 14.

The plaintiff also offered a certified copy of pleadings and charge of the court in the case of Edwin May vs. Johnson County, Indiana, an action for infringement of the same patent, tried in the U. S. Circuit Court for the District of Indiana in 1872. The defendant objected to it as irrelevant and immaterial.

Record, p. 14.

These several objections were overruled, and due exceptions were severally taken.

In regard to the measure of damages, it was shown that the patentee and the plaintiff had established and collected a royalty of $50.00 per cell, both where there had been previous infringements of the patent and the infringer had settled, and where the county or builder of the jail had desired to purchase the right.

But it was not shown that such royalties or any royalties had been paid for the use of the angle observation door under the first claim, or of the combination claimed in the third claim, or that such royalties or any royalties had been paid simply for the use of the combination described and claimed in the fourth claim, irrespective of the use of the angle observation door or the contrivance for closing and locking the corridor doors in the same jail at the same time, and without the use thereof, or of either of them, in the same jail at the same time.

Record p. 14.

When the plaintiff rested, the defendant moved that a verdict be directed for the defendant on the grounds that—

1. The plaintiff has established no cause of action against the defendant.

2. The patent in suit is void for lack of novelty, and because the combinations described are not operative combinations, and are old and well known devices long applied to similar uses.

3. The plaintiff is not the owner of the cause of action sued on.

4. The statute of limitations of Wisconsin has run upon the alleged cause of action.

The motion was overruled, and due exception was taken.
Record, p. 14.

On the part of the defendant it was shown that the device of locking the doors in defendant's jail was put on when the building was constructed, in 1869, and by the contractors who built the jail under contract; that at the Wisconsin State Prison, at Waupun, Wis, and at the Elmira, N. Y., or Chemung County jail, and elsewhere, there had been in common and public use, well known to many persons, for many years before 1859 a device consisting of a lever, a bar, and lugs or bolts attached, operated substantially as described in the patent, to lock or unlock the cell doors, but without any intervening wall, corridor grating or other protection to the jailer against attack; that such device, except for the absence of a corridor wall or grating, was substantially identical with, and a mechanical equivalent of, the device described in said patent and claimed in the fourth claim thereof, and that it was used and did operate in the same way to lock or unlock the cell doors after they had been closed.
Record, pp. 14, 15.

The defendant also, on cross-examination of Luther V. Moulton, the plaintiff's expert witness (Record, pp. 12, 13), brought out these facts:

The novelty of the patented device consists in interposing a grating between the jailor and the prisoner at each stage of shutting or opening the several doors. The several elements of the device are old. The witness had seen angle doors and curved doors in use and in illustrations many years before 1859.

In defendant's jail, the corridor doors are not closed by the fastening mechanism described in the patent, but *when closed by the prisoners or turnkey* they are *locked* by bolts moved by rock-shafts extending from the outer apartment through the wall into the jail proper and to the corridor doors. There is nothing new in a rock-shaft applied to transmit motion to bolts or other like uses; it is the equivalent of an endless chain or any other well known device for transmitting motion and is very old. The operation and effect of the rock-shaft, the lever that moves it and the bolts that it moves at the corridor doors, thereby locked or unlocked, is precisely the same with or without a wall or grating between the handle and the door. In the Fond du Lac jail, the handle of this rock-shaft and the place where it is operated are a few feet distant from the angle-door. There is a slit in the wall by these handles of the rock-shafts, through which two corridors, one over the other, on one side of the jail, can be observed, but the other side of the jail, with its two corridors and two tiers of cells, cannot be observed. The doors of all four corridors are locked by rock-shafts all starting and moving from the same point.

The operation and effect of the arrangement of the lever *b*, the bar *a* and the bolts or lugs S, as described in the patent, are precisely the same, whether the lever is operated through a wall or grating, or whether none is there. Mechanically, the effect is precisely the same, with or without the grating, so far as fastening and unfastening the doors is concerned. The only difference is in the effect of the grating to protect the jailer and guard against escapes. Every separate element of the combination in the fourth claim is old. Levers have been used long before this patent, to move a long bar and thereby move bolts or the like, at a distance; so also similar devices passing through a wall to open and close and secure window shutters and the like; but this particular combination adapted to interpose protection between the person operating the device, and those on the other side of the wall or grating, was new. The grating has nothing to do directly with locking or unlocking the doors. It affords protection to the operator while so doing. So with the third claim of the patent; all its elements are old; it is only the particular combination applied to this purpose that is new.

Record, pp. 12, 13.

The Record contains all the evidence, and a bill of exceptions thereof was duly sealed

When the evidence was closed, the defendant renewed its motion for direction of a verdict upon the same grounds as before; which was denied and the defendant excepted.

Record, p. 15.

The defendant then prayed instructions to the jury as follows:

1. The first claim of the patent is void.

2. The third claim of the patent is void.

3. The fourth claim of the patent is void.

4. The first claim does not claim a new device, nor is the combination described and thereby claimed an operative combination but it is a mere aggregation.

5. The third claim does not describe a new device.

6. It is for the jury to decide whether the third claim is infringed by the defendant's device.

7. It is a question for the jury whether there was an invention or exercise of the inventive faculty in the construction of the devices described in the patent.

8. The plaintiff cannot recover for any use of the patented contrivances of the plaintiff or of any of them prior to the 29th day of September, 1879, because for any such prior use the action was not brought within the six years prescribed by the statutes of Wisconsin.

9. Confining the period for which recovery can be had to that between September 29, 1879, and October 4, 1880, the jury are entitled in assessing the damages to consider the length of use and to allow less damages in their discretion for that amount of use than the royalty established by the patentee, or less than would be a proper measure of compensation for a longer use.

10. The royalty asked and paid is not conclusive on the jury. The jury are to to take into consideration the time and extent of infrigement, and may allow less than the regular royalty for a time materially shorter than the period of the patent, and it is for the jury to decide on the amount of damages.

Each of which prayers was severally denied, and a several exception was taken.

Record, pp. 15, 16.

The charge to the jury is found at pp. 16–22 of the Record. It was also reported in

May v. Fond du Lac County, 27 Fed. Rep. 691.

The defendant took exceptions to certain portions of the charge, as noted at page 22 of the Record. Those passages of the charge will be stated in our assignment of errors.

The defendant duly moved for a new trial on these grounds of error:

1. In admitting evidence against the defendant's objection.
2. In the charge to the jury.
3. In declining to give to the jury the instructions.
4. In the refusal to direct a verdict.

5. In the refusal to rule that the plaintiff is not the owner of the alleged cause of action.

The motion was denied, and due exception was taken.
Record p. 9.

The defendant also duly moved in arrest of judgment, on these grounds:

1. That the letters patent were and are void, because it appears on the face of the record that none of the several claims therein stated is for a patentable invention, contrivance or combination; and that none of the several combinations therein stated and claimed as the patentee's invention is a new or patentable invention.

2. That the plaintiff does not appear upon the face of the complaint to be or to have ever been the lawful owner of the cause of action sued upon.

THE ASSIGNMENT OF ERRORS.

The plaintiff in error (defendant below) assigns for errors that the court erred:

1. In ruling that the patent was valid, and overruling each of the objections to its validity above set forth.

2. In ruling that the proceedings in the Marion County Circuit Court operated to pass the title in the alleged cause of action to the plaintiff, and that she is the owner thereof.

3. In ruling against the defendant's plea of the statute of limitations, and refusing to limit the evidence of infringement to the period between September 29, 1879, and the expiration of the extended term.

4. In the admission of sundry matters of evidence above set forth.

5. In overruling the defendant's motions that a verdict be directed for it.

6. In ruling that the defendant, being a county, was liable for infringement of the patent in question, and that any cause of action was established against it.

7. In refusing to instruct the jury that the first claim of the patent is void.

8. In refusing to instruct the jury that the third claim of the patent is void.

9. In refusing to instruct the jury that the fourth claim of the patent is void.

10. In refusing to instruct the jury that the first claim does not claim a new device, nor is the combination described and thereby claimed an operative combination, but it is a mere aggregation.

11. In refusing to instruct the jury that the third claim does not describe a new device.

12. In refusing to instruct the jury that it is for them to decide whether the third claim is infringed by the defendant's device.

13. In refusing to instruct the jury that it is a question for them whether there was an invention or exercise of the inventive faculty in the construction of the devices described in the patent.

14. In refusing to instruct the jury that the plaintiff cannot recover for any use of the patented contrivances or any of them before September 29, 1879, because the action was not brought within six years after such prior use.

15. In refusing to instruct the jury that confining the period for which recovery may be had to that between September 29, 1879 and October 4, 1880, the jury are entitled in assessing damages to consider the length of use and to allow less damage in their discretion for that amount of use than the royalty established by the patentee, or less than would be a proper measure of compensation for a longer use.

16. In refusing to instruct the jury that the royalty asked and paid is not conclusive on the jury; and that the jury are to take into consideration the time and extent of infringement and may allow less than the regular royalty for a time materially shorter than the period of the patent, and it is for the jury to decide on the amount of damages.

17. In instructing the jury that —

"The patent law recognizes as patentable an improvement in any art or mechanical construction or combination which is useful to the public and not before known. To be patentable a thing must not only be new and useful, but must amount to an invention or discovery. Although the result is produced by a mechanism which combines old mechanical elements or powers without the use of any new element, the true question in such a case is whether the combination of elements by the patentee is new. If they have never been combined together in the manner stated in the patent, and if the combination is new and useful, not being the result of mere mechanical skill, but of invention, then it is patentable. Each and all of the separate parts of a combination may be old and well known. The combination may contain the lever, the pulley, the wheel, and other well-known and long-used devices which would not, separately be patentable; nevertheless, if the combination is new and produces a new and useful result, it —that is, the combination—is patentable. Almost all combination structures are made up of separate parts and elements which are old and well known, and if that fact alone would invalidate a patent some of the most valuable inventions of the present day would at once become the common property of the public, and valueless to their owners. The law does not encourage or sanction the defeat of combination patents on the ground that the several parts are old, if the combination is new and useful."

Record, p. 18.

18. In instructing the jury upon the subject of infringement as follows:

"An infringement takes place whenever a party avails himself of the invention of the patentee without such variation as will constitute a new discovery. An infringement involves substantial identity, whether that identity is described by the terms, the same principle, the same *modus operandi*, or any other. It is a copy of the thing described in the specifications of the patentee, either without variation or with only such variations as are consistent with its being in substance the same thing. No certain, definite rule can be stated by which to determine unerringly in every case what will amount to substantial identity; the jury, guided by general principles, must determine each case upon its own circumstances. If, however, the invention of the patentee be a machine or an improvement on a machine it will be infringed by a machine which incorporates in its structure and operation the substance of the invention—that is, by an arrangement of its mechanism which performs the same service or produces the same effect in the same or substantially the same way. The question is, Whether the given effect is produced substantially by, the same mode of operation and the same combination of powers and devices in both machines? Mere colorable or evasive differences cannot defeat the right of the original inventor. The inquiry, therefore, should be whether the defendant's device is in substance and effect a colorable evasion of the plaintiff's contrivance, or whether it is really a new and substantially different thing."

"If the defendants have taken the same general plan and applied it for the same purpose and produced the same effect in substantially the same mode, although they have varied the form or construction in some respects merely, it will be, substantially, in contemplation of the patent law, the same thing; otherwise it will not. Whether or not one machine is an infringement of another, therefore, does not necessarily depend upon whether the mechanical constructions are different; but the question is whether, whatever be the mechanical construction, the latter machine contains the means or combination found in the previous machine; whether, taking the structure as you find it, you see the new idea completely embodied in it."

"If the defendants have only varied their combination by employing well-known mechanical substitutes for some one or more material elements, or parts of the plaintiff's combination, then there is an infringement; for a mere known mechanical substitute for a thing for the purpose of determining the question in issue must be regarded as the thing itself."

"When, in mechanics, one device does a particular thing or accomplishes a particular result every other device known and used in mechanics which skillful and experienced workmen know will produce the same result or do the same particular thing is a known mechanical substitute for the first device mentioned for doing the same thing or accomplishing the same result, although the first device may never have been detached from its work and the second one put in its place. It is sufficient to constitute known mechanical substitutes that when a skillful mechanic sees one device doing a particular thing that he knows the other devices, whose uses he is acquainted with, will do the same thing."

"Now within these definitions, does the structure used by the defendant infringe the May device? In their general scope and object they seem to be quite alike and are evidently intended to secure the same result. Do they differ essentially in their organization or mode of operation? The one is evidently equivalent to the other as producing the same result; but in this sense it is not material to consider the subject. The question is whether the defendant has used substantially the same means or, mechanically speaking, equivalent means to accomplish the same result. If it has it is an infringer; otherwise not; and whether it has or not is a question for the jury to determine. As we have seen, a mechanical equivalent, as generally understood, is where one may be adopted instead of the other by a skilled mechanic accustomed to machinery, with a competent knowledge of mechanical powers. If such a man, seeing a new machine and having a full description of the thing invented, can, by examining it with care, see that the required thing can be done in a different mode and it is done in that different mode by the knowledge which he has of his business, he has not produced a new invention nor one substantially differing from the original; but if the inventive faculties are exercised to produce the change, then he has a right to the benefits of whatever he thus invents. There must be invention involved in the change and not the mere skill of the workman, to avoid the consequences of an infringment. The question here is, does the structure used by the defendant substantially embody May's mode of operation and thereby obtain the same kind of results as were reached by his invention? It is not necessary that the result should be precisely the same in degree, but it must be the same in kind. For instance, shutting one door instead of two is a difference in degree but not in kind; the same function is performed."

"Now, keeping in mind that the May invention consists of certain mechanical means which enable the jailer from the moment he enters the outer door to control the prisoners by fastening the corridor doors while separated from them, the question is, Do the means employed by the defendant in its jail infringe them? Has the defendant used the plaintiff's invention or something substantially like it? Do the structures operate upon the same principle? If there are differences, are they or not mere differences in form, producing the same result? The plaintiff's invention secured to the inventor not only the particular means described in the patent, but all other mechanical contrivances which are equivalents. When these mechanical arrangements are thus compared and analyzed, if differences be found, it is for you to determine whether these differences are substantial or are only formal and evasive, arising from employing in the defendant's jail in the place of those specific parts or devices of the May combination other known mechanical substitutes therefor. If substantial, then there is no infringement; but if merely formal or evasive and not substantial there is an infringement."

19. In instructing the jury upon the subject of damages as follows:

"The undisputed evidence shows, I think, the fixed royalty of fifty dollars for each cell at which the plaintiff's device or the right to use it was sold by the patentee in his lifetime. In such case it is the ruling of the courts that such royalty constitutes the proper measure of damages. If, therefore, you find plaintiff entitled to recover you will allow her damages at the sum of fifty dollars for each cell in the Fond du Lac jail on which the invention was used prior to October 4, 1880, and subsequent to October 4, 1873."

20. In denying tne motion for a new trial.

21. In denying the motion in arrest of judgment.

THE ARGUMENT.

The preceding summary of the facts and exceptions of record will enable the court to see that there is involved in this case the questions:

1. Whether there is any cause of action against any person?

2. Whether the cause of action, if any there be, is such that the plaintiff in error is liable thereon?

3. Whether the cause of action, if any there be, is the property of the defendant in error?

4. Whether the cause of action, if such there ever was against the plaintiff in error, still subsists to the full original extent, and whether the same damages are recoverable as were originally recoverable?

Upon each of these questions, the plaintiff in error maintains the negative, and the defendant in error the affirmative. And if the plaintiff in error prevails on any of the four main propositions indicated, the judgment below must be reversed; while to sustain it, the defendant in error must prevail on all of its contrary propositions. For the judgment is equally erroneous, if there be no valid patent or no infringenent, or if the action does not lie against the county in such a case, or if the plaintiff does not own the cause of action, or if the verdict was not based on the true measure of damages.

FIRST.

THERE WAS NEITHER ANY VALID PATENTED DEVICE NOR AN INFRINGEMENT THEREOF IN THE CASE AT BAR.

To avoid misapprehension, let us re-state here the three claims on which the defendant in error rested her case, and as to all of which she obtained a verdict:

1. The angle-door D, in combination with the safe lock or bolt I, when constructed and operated substantially as set forth.

3. The endless chain or rope *e*, in combination with the levers *d*, when constructed and operated substantially as and for the purposes set forth.

4. The combination and arrangement of the levers *b*, bar *a*, and bolts or lugs S, when operated from without the grating I, substantially as and for the purposes set forth.

As the court takes judicial notice of mechanical contrivances which are old and in common use, and there is testimony here, from the expert Moulton, that an angle-door is an old and familiar contrivance, it is plain that the combination covered by the first claim is not novel. There is neither novelty nor invention in the angle-door; and as doors and locks of many kinds have been used in combination for many ages, for all conceivable purposes, there can be in the nature of things nothing patentable in the combination of an angle-door and a lock of any kind, even though that particular combination is novel. At most it is no more than a double use.

Brown v. Piper, 91 U. S. 37.
Roberts v. Ryer, Id. 157.
Terhune v. Phillips, 99 Id. 592.
Tucker v. Spaulding, 13 Wall. 453.

This would be true, if there were nothing peculiar about the location or nature of the bolt I. But if it is construed, in the light of the specifications as an integral part of the apparatus of the safe or box J, with its drum and connections, then the combination in the first claim is no more patentable than if there were only a bolt and an angle-door, and at the same time there is no infringement. An inspection of the model of the county jail shows that it has only a bolt and a door.

When we come to the subject matter of the third claim, viz.: the entire apparatus for closing and unclosing the sliding doors in the grated corridor partition while the turnkey is outside of the angle door, we find that its scope and purpose is very clearly defined and limited to precisely that operation—"*closing* the doors"—and that purpose—"always keeping an iron partition between the keeper and the prisoners." The partition doors are to be closed before the turnkey steps within the angle-door. The differences between this contrivance and that shown in the model of the Fond du Lac jail are marked. No drum, crank, endless chain, or levers such as described are found there. Four rock-shafts are operated from a place several feet distant from the angle-door. There a perpendicular slit in the wall wherein the angle-door is set affords means of observation of the upper and lower corridors in the line of sight from that slit. There is no corresponding slit on the other side of the angle-door; but all four rock-shatts are operated from that same slit. No doubt levers, endless chains and rock-shafts are or may be mechanical equivalents for each other; and a charge of infringement is not avoided by a substitution of one for the other. But the point here is that the two mechanisms have a totally different operation and effect. The patented device *opens and closes the sliding-doors, while the turnkey is outside of the outer or angle-door. The device in use here only locks or unlocks the sliding doors, after the turnkey has passed within the angle-door and closed the sliding doors*. See Moulton's testimony, pp. 12–13 of Record.

There is a total absence of the element of protection of the jailer from harm, and prevention of the prisoner from escape, by the constant interposition of a barrier between the two. The precise scope of the third claim, as explained by the specifications, is this interposition of a barrier. Without it, the mechanism of the third claim is nearly or quite as ancient as that of a ship's wheel, rudder-chains and rudder, operated from the wheel-house; and it is exemplified in a thousand different forms in a hundred different arts.

The fact, that the angle-door is in fact closed in the Fond du Lac jail, after the turnkey goes within, to close the sliding doors, and stands shut when the rock-shaft moves the bolts to lock the sliding doors is of no more importance under the patent law, than is the fact that a glass door intervenes in a street-car between the driver and the rear door which he closes by a rock shaft at his seat. There is, then, no infringement of the third claim; because if patentable at all, the third claim is not duplicated either in construction, operation or it's mechanical equivalents by the device in use at our jail.

The devices covered by the third and fourth claims may best be considered together, as to their patentability, because they are alike in the only feature which is asserted of making them patentable, viz: the interposition of a barrier. In both claims this feature exists. In the third claim the device operates to open or close the sliding door while the angle-door is locked. In the fourth claim the device operates to lock the doors by means of the lugs after they are closed, and while the corridor grating is securely closed. In the Fond du Lac jail, the device which is alleged to correspond to the third claim operates, as we have shown, to *lock*, not to *close*, the sliding-door irrespective of the interposed barrier, and indeed requires that that barrier shall be dispensed with—that is that the turnkey shall go within the angle-door while the corridor doors are still open in order to shut them, and then the rock-shaft shoots the bolt that locks the door. In the Fond du Lac jail, the device corresponding to the fourth claim operates just as that does. The one feature that distinguishes the patentee's third and fourth claims and the County's cell-locking device from many well-known and long-used devices for transmitting motion to a distance, is the fact of the barrier being interposed for security. If that fact does not confer patentability, there is no pretense that it exists in this case.

We maintain that these two devices are not patentable for the reasons that:—

First, they are not novel.

Second, if novel, they lack invention.

Third, if novel and exhibiting invention, each of them is a mere aggregation, not an operative combination.

1. The testimony of Mr. Moulton, evidently a competent and

well-informed expert, shows that a combination consisting simply of either a rock-shaft or an endless chain and pulley with a bolt or a lever to transmit motion to bolts or doors at a distance is very old. He says the same as to the combination of a lever, bar, and bolts or lugs for locking and unlocking cell doors. See his cross-examination on page 13 of the Record. The evidence for the defense at page 15 of the Record shows the same fact as to the cell-locking devices more positively. It is there shown that at the Wisconsin State Prison, Waupun, Wis., and at the Elmira or Chemung Co. jail in New York and elsewhere, there had been in common and public use and well known to many persons, for a number of years before 1859, substantially the same device, except that it lacked the interposed barrier. Mr. Moulton also admitted that similar devices had long been used by which a long bar passed through a wall to open and close window-shutters and the like, and that such bar was moved by a lever inside the wall to produce the effect outside. Such devices are now in such common use for one purpose or another that the court can and will take judicial notice of them. In the case of

Stevenson v. Brooklyn C.-T. R. R. Co., 114 U. S. 149,

it was held that there was nothing novel in a device consisting of a rock-shaft running lengthwise through a street-car and operated by a lever at the front end to open or close a door at the rear end of the car. In the opinion, other similar devices to open and close sliding window-blinds and the like are referred to. We candidly admit that the precise device here claimed, including the interposed barrier, and used in a jail for the protection of the jailer and the prevention of escape, has not been before used, so far as the Record shows. But that alone is not enough to constitute patentable novelty. We do not understand the patent law to discriminate between motives, or to reward intentions however benevolent. The inventor of the most destructive cannon is rewarded equally with the inventor of the life-saving mortar. The law regards only mechanisms and results. The end which one inventor intends to subserve by the use of his apparatus may be gain, that of another convenience, that of a third the repression or punishment of crime, and that of a fourth the saving of life. The law applies to them all the same test. Now there were in common and public use, before this patent, these devices of opening and closing street-car doors, window-shutters and the like, which corresponded in all respects to the devices under either the third or fourth claim. They contained the same mechanical elements, they had the same operation and mechanical effect, and the total combination was the same, viz., a lever, a bar passing through or beyond some interposed barrier, a lever or its equivalent at the other end, and a thing or things to be moved by the motion thus transmitted through the barrier by the lever and the bar. The intentions of the inventors of the previous devices apparently were to promote economy, convenience, or both. The intention of Mr. May was more securely to control prisoners and more surely protect the life of their keeper. But he used substantially the same devices which had before been used by other persons, for many years, with other motives, *but to the same mechanical effect.* Now the essential novelty of the patent law lies not in motive or intention or in use, but in operation and effect. This is, therefore, nothing but a case of a double use. A person familiar with the proper state of mechanic arts, in transmitting motion or power in any of the devices above suggested, or many similar ones which might be suggested, upon turning his mind to the subject of making secure and convenient locking devices in jails, would naturally have thought of those prior devices and adopted some one of them. Of the many cases that might be cited, we cite only the following, in illustration of a principle so well known that it does not need authority in its support

Tucker v. Spaulding, 13 Wall. 453.
Brown v. Piper, 91 U. S. 37.
Burt v. Evory, 133 Id. 349.
Hill v. Wooster, 132 Id. 693.
Watson v. C. I. St., L. & C. R. Co., 132 Id. 161.
Aron v. Manhattan R. Co., 132 Id. 84.
St. Germain v. Brunswick, 135 Id., 227.

Second. If, however, the devices are in a strict sense novel, they are not the result of invention. It has ever been the aim of builders of prisons to securely keep the prisoners and protect the jailers from attack. That is the reason of the multiplied bolts and bars. The question is: Is there invention in putting a grating between the jailer and the door which he locks? Wherein does it reside? It is, mechanically, not different from the same operation without a barrier. It is, in effect, the same as the many operations of producing motion of levers or other things at a distance beyond walls or other barriers, which may be seen in any factory. If one were to propose to lock a cell-door by a key with a long shank projecting through a grating opposite to the door, instead of by a short key, it would doubtless be safer, but it would not be an invention. Mr. Moulton testifies as to both the third and fourth claims that the mechanical operation and effect is the same, with or without any intervening barrier. As there is admittedly nothing novel in these mechanisms without any barrier, and no different operation or effect with them, and furthermore as the same mechanical effect had long before been produced by like combinations with an intervening barrier, but for different purposes, there does not seem to be any real invention in suggesting this particular use of the mechanism, including the barrier.

Heald v. Rice, 104 U. S., 754.
Hall v. Macneale, 107 Id., 90.
Thompson v. Boisselier, 114 Id., 1.
Dunbar v. Meyers, 94 Id., 187.
Stephenson v. Brooklyn C.-T. R. R. Co., 114 Id., 149.
Also, see cases above cited.

Third. Even if otherwise patentable, these claims lack the element of co-operation. The devices described are mere aggregations. Reflection on the nature of the thing described and on its operation shows this at once, and the testimony of Moulton confirms it. He says that the operation and effect are precisely alike, with or without the grating or other barrier. The different elements, while in a relation of juxtaposition, are not in any relation of mechanical assistance or joint effect The grating, then, performs no mechanical function and has no mechanical effect. It is simply a *petitio principii* to argue, as Mr. Moulton does, that the device is patentable because the grating in combination with the other elements *operates* to protect him who works the lever. It is *operation* in the same sense that the prison wall operates—to keep the prisoner from escaping—no more and no less.

Double-Pointed Tack Co., v. Two Rivers Mfg. Co., 109 U. S. 117.
Pickering v. McCullough, 104 Id. 318.
Hendy v. Golden State etc. Works, 127 Id. 370.
Stephenson v. Brooklyn C.-T. R. R. Co., 114 Id. 149.
Aron v. Manhattan, R. Co., 132 Id. 84.
Forbush v. Cook, 2 Fisher, 669.

SECOND.

THE COUNTY IS NOT LIABLE FOR INFRINGEMENT OF A PATENTED DEVICE USED IN ITS JAIL.

This proposition rests upon the distinction between municipal and *quasi* corporations, and their relative *corporate* and *public* functions and character. In the exercise of its duties as a representative of the state, wielding to a certain extent its sovereign powers as conservator of public rights and represser of crime, the county arrests, convicts and imprisons persons accused of crime. As incidental to the due discharge of this function, and in obedience to statute, it acquires and occupies a jail. But in all this it locally stands for the state, *quoad hoc* it is the state. This distinction between municipal corporations proper and *quasi* corporations, such as counties and towns, is well known.

Dillon on Municipal Corporations, (4th Ed.) §§ 22-27, 966, 997.

It is a *public*, not a *corporate* duty to build a jail. No civil action lies for non-feasance or mis-feasance in respect of it. If any benefit accrues from it, it comes only as the like would come to the state from building a prison; and the state as sovereign could not be sued. As the county acts only through its board of supervisors, which carries out the legal duty to provide a jail, it follows that the liability rests on either the board of supervisors, or its building committee, or the contractor. In this case, it is in proof that the contractor built the jail in 1869 and put in the devices which are alleged to infringe; that the county's agent, the sheriff, went into possession, and finding the locking devices there, used them and his successors in office continued to use them. Now the county paid an agreed price for the jail as completed. If the May patent was valid, and the contractor desired to put such devices into the jail, it was his duty to do so lawfully, by purchase, not by trespass; and he is the infringer. His contract price covered whatever was to be put into the jail; and it was his duty to pay for whatever he did put in. There is no difference between patents and bricks in this. It is not to be presumed that the county contracted with him that he should put in a patented article, any more than an iron beam, without payment. And there is no evidence here that the county contracted for any locking device of this or similar character, or for anything more than ordinary locks, gratings and doors of suitable strength. It is the contractor, then, not the county, who has made and sold the infringing devices. He has been paid for them and the infringement has benefitted him, not the county.

Upon the same principle the county cannot be held liable for the use of the devices put in its jail. It has assumed no contractual liability in respect of them; and it is not liable in tort, without a statute creating such liability. Its sheriffs, if any one, are liable. The doctrine of *respondeat superior* does not apply.

The distinction here insisted on, and the doctrine of non-liability of counties and towns in tort for any damage resulting from the discharge of their public or semi-sovereign functions which is deduced from it, is well expressed in the following passages:

"In the United States there is no common law obligation resting upon *quasi* corporations such as counties, townships and New England towns, to repair highways, streets or bridges within their limits and they are not obliged to do so unless by force of the statute. Even when the legislature enjoins upon corporations of this character the duty to make and repair roads, streets and bridges, and confers the power to levy taxes therefor, the general tenor of the decisions is to treat this as a *public*, and not a *corporate* duty, and to regard such corporations, in this respect as public or state agencies, and not liable to be sued civilly for damages caused by the neglect to perform the duty, unless the action be expressly given by statute."

2 Dillon, Mun. Corp. §997 (4th Ed.)

In the case of

Com'rs. of Hamilton Co. v. Mighels, 7 Ohio St. 109, 118 which is one of the leading cases on this subject, it is said:

"Municipal corporations are called into existence either at the direct solicitation or by the free consent of the people who compose them. Counties are local subdivisions of the state, created by the sovereign power of the state, of its own sovereign will, without the particular solicitation, consent or concurrent action of the people who compose them. The former organization is asked for, or at least assented to, by the people it embraces; the latter is superimposed by a sovereign and paramount authority." * * * *

"A municipal corporation proper is created for the interest, advantage and convenience of the locality and its people; a county organization is created almost exclusively with a view to the policy of the state at large, for purposes of political organization and civil administration, in matters of finance, of education, of provision for the poor, of military organization, of the means of travel and transport, and especially for the general administration of justice. With scarcely an exception, all the powers and functions of the county organization have a direct and exclusive reference to the general policy of the state, and are, in fact, but a branch of the general administration of that policy. Ward v. County of Hartford, 12 Conn. 406; Roatt v. Commissioners of Williams County, 18 Ohio, 16; C. W. & Z. R. R. v. Commissioners, 10 Ohio St. 89."

Another leading case, reviewing the whole subject and all important authorities most thoroughly is

Hill v. Boston, 122 Mass., 344,

in which this doctrine was even applied to a chartered city, in respect to functions which it performed solely in a public capacity, and in obedience to a general statute applying alike to all cities and towns.

Commonwealth v. Brice, 22 Pa. St., 211,

holds that the county *is a part of the body of the state;* and on that ground exonerated a county from liability for neglect of its commissioners to retain from moneys due the sheriff sums which he owed the county for fines and jury fees collected by him. The opinion says:

"The fact that a county has certain rights recognized in law as its own does not sever it as a body from the state; but only distinguishes it in the state, and as a part of it, and allows local officers to enforce, in the name of the county, certain rights and duties which otherwise would have had to be enforced in the name of the state. The institution of local divisions is merely a means of government, and counties and their officers are but parts of the machinery that constitute the public system. This form of administration is no more a division of the government than is the allotment of particular localities, or particular functions to what are usually called state officers."

In Lorillard v. The Town of Monroe, 11 N. Y., 392,

a town was held not liable for taxes illegally collected from lands in another town. After stating that towns are limited corporate bodies, and their powers in certain respects, the court says:

"In all other respects, for instance, in everything which concerns the administration of civil and criminal justice, the preservation of the public health and morals, the conservation of highways, roads and bridges, the relief of the poor, and the assessment and collection of taxes, the several towns are political divisions, organized for the convenient exercise of portions of the political power of the state, and are no more corporations than the judicial or the senate and assembly districts. The functions and the duties of the several town officers respecting these subjects are judicial and administrative, and not in any sense corporate functions or duties. * * * * * When chosen they (the assessors) are public officers, as truly as the highest official functionaries in the state. Their duties in no respect concern the strictly corporate interests of the town, such as their common lands and their corporate personal property, or the contracts which they as corporations are permitted to make, nor are their duties limited to their effects on the towns as political bodies."

This decision was followed in

People *ex rel* Van Keuren v. Auditors, 74 N. Y. 310.
" " Loomis v. " 75 Ia. 316.

Mehr v. Gage Co., 5 Neb, 494,

holds a county not liable for a nuisance from unhealthy condition of its jail.

The following are a few of the many cases illustrating and enforcing the doctrine of non-liability of counties and towns in tort for either mis-feasance or non-feasance of its officers in various phases. No distinction is drawn between mis-feasance and non-feasance.

Ward v. Hartford Co., 12 Conn. 406.
Wilson v. School Dist., 32 N. H. 118.
State v. Leffingwell, 54 Mo. 458.
Kincaid v. Harden Co., 53 Iowa, 430.
Askew v. Hale Co. 54 Ala. 639.
Soper v. Henry Co. 26 Iowa, 264.
Treadwell v. Commissioners, 11 Ohio St. 190.
Hollenbeck v. Winnebago Co., 95 Ill. 151.
Stilling v. Town of Thorp, 54 Wis. 528.

Bigelow v. Randolph, 14 Gray, 541.
Eastman v. Meredith, 36 N. H. 284.
Western College v. Cleveland, 112 Ohio St. 379,
which holds a city not liable for neglect of police to quell a mob.

Mr. Freeman in 60 Am. Dec. 290,in an elaborate note to the case of
Gilman v. Contra Costa Co., 8 Cal. 52.
collates many other cases on the subject.

The functions of a county in building a jail are unquestionably public and administrative, not corporate. We admit that the county would be liable for material which it bought and used in the construction of a jail, and so too it would be liable on its contract with another to build a jail for it, or on its contract for purchase of land for a jail site. But that is not because the county takes such material and such land and uses it for jail purposes, for in doing so it is simply carrying out a public function and is no more liable for that act than the State would be in a like case. It is because the statute has made the county *liable by authorizing it to build a jail,* and all acts done by the county in pursuance of that purpose rest on the statutory liability. On the other hand, no statute has either authorized the county to commit a tort or made it liable for the commission of one by its officers. The infringement of a patent is as purely a tort as any other wrong, committed by force or without force, with malice or by neglect.

The precise point for which we contend was decided by the Circuit Court of the United States for the Eastern District of Ohio, in

Jacobs v. Comrs. of Hamilton Co., 1 Bond, 500,

following Mighels v. Comrs., cited *supra.* The court says that it can make no difference in the principle of the two cases, that in the Mighels case the tort was an act of non-feasance, while in this case it is an act of mis-feasance. "The principle involved is precisely analogous, whether the cause of action alleged is the wrongful omission to perform a duty or a positive act of mis-feasance. In either case there is no law by which the people of a county are responsible to the injured party for an injury sustained by the tort. The right to recover in either case must rest on an express statutory provision. There can be no pretense of any such right in virtue of the common law. This proposition is beyond all doubt in an action for the infringement of a patent right granted by the laws of the United States. The patent itself, with all the privileges which it confers, is the creature of the statute; and it is clear there can be no remedy for the violation of the patent, except as it is conferred by the statute."

The court further says that the contractor of the board of commissioners, being guilty of the infringement, was liable to the plaintiff for such infringement.

This ruling was also applied to the patent in suit by

May v. County of Juneau, 30 Fed. R. 241.

THIRD.

THE PLAINTIFF IS NOT THE OWNER OF THE CAUSE OF ACTION IN SUIT, IF ANY SUCH EXISTS.

This proposition depends upon the well-settled distinction between the title to the patent and the title to the cause of action for past infringements. Of course the ownership of the patent implies the right of action for future infringements. But the moment that an infringement occurs, a cause of action for it is vested in the then owner of the patent, as a right distinct from the monopoly of making, using or vending the patented devices. It becomes severed, so to speak, from the patent right itself. A conveyance of the patent itself even in broad and general terms will not pass the title to the cause of action for past infringements, without words specially adapted to that separate right.

Moore v. Marsh, 7 Wallace, 515.
Dibble v. Augur, 7 Blatch., 86.
May v. County of Juneau, 30 Fed. Rep., 245.
Koalatype Co. v. Hope, 30 Id., 444.

It appears in this case that after regular proceedings in the Probate Court having jurisdiction of the estate of the patentee for the appointment of an administrator, and for authority to him to sell this and five other letters patent, such authority was given him on or after December 31, 1881. (Record, pp. 28,29.) The language of the petition is that all the assets of the estate had been sold and distributed, "except the rights of such decedent in letters patent from the United States of America, which have not been disposed of; that there now offers a favorable opportunity for selling such rights; that the same are of little value." The language of the order of leave to sell is, "that the administrator is now authorized and empowered by the court to sell *said rights* at private sale." On March 7, 1882, the administrator filed his report, stating that he had made diligent efforts to secure bids "for the rights of said estate in certain letters patent", and that on Jan. 19, 1882, "Sarah May did bid therefor the sum of fifteen dollars, and that being the best offer the administrator could procure,such rights of this administrator were sold to Sarah May." (Record, p 29.) His deed was thereupon submitted and approved. The deed recites by name, date and number six patents. The first is the patent here in suit. All the other five had then from 4 to 5 years to run. The terms of conveyance are, "that in consideration of the said sum of fifteen dollars, I, the said George F. McGinnis as administrator, etc., have sold, assigned, transferred, and set over unto the said Sarah May all the right, title, interest, claims and demands whatsoever which the said estate of said Edwin May, deceased, has in, under, by and through said improvements and the letters patent and extensions thereof therefor aforesaid."

It is true these are broad terms; but they do not in their legal import go beyond the petition or the order of leave. And they do not go beyond the terms which the cases above cited have settled as importing a conveyance of a title to the patent itself and not of the title to the rights of action for past infringements. It is also true that the extended term of the patent here in suit had expired; but five other patents were sold with it which had not expired and the unexpired terms of which were presumably of some value. And the whole six patents were sold to the widow of the patentee for fifteen dollars. These facts rather militate against, than make for, the plaintiff's claim of right to sue for past infringements.

It is rather to be presumed that this particular patent was put in with the five other unexpired patents, simply to enable the administrator to clear up all the apparent assets of the estate which he had inventoried and close his account, than with any thought of passing rights of action for past infringements of this particular patent. If that had been in mind, what more natural than to use apt terms to express just that intent? And it is no hardship to the plaintiff to hold her strictly to the legal import of language used by a friendly administrator of her husband in selling to her for a nominal sum her husband's patents, upon the strength of which sale she has been suing at least a dozen counties in several states, as the reports of the Federal circuit courts show, for alleged damages amounting to thousands of dollars.

This point, as well as others in the case at bar, is involved in the case of May, Plaintiff in Error, vs. County of Juneau, Wisconsin, which is on the present calendar of this court; and we beg leave to refer the court to the brief of the able counsel who represent that county.

FOURTH.

THE STATE STATUTE OF LIMITATIONS APPLIES TO THE CAUSE OF ACTION FOR INFRINGEMENT MORE THAN SIX YEARS BEFORE SUIT, AND THE RIGHT OF RECOVERY BEING THUS LIMITED, THE MEASURE OF DAMAGES LAID DOWN BY THE COURT WAS ERRONEOUS.

The language of the Wisconsin statute is:

"The following actions must be commenced within the periods respectively hereinafter prescribed, after the cause of action has accrued."

* * * *

"Within six years:

* * * *

" 5. An action to recover damages for an injury to property, real or personal, or for an injury to the person, character or rights of another not arising on contract, except in a case where a different period is expressly prescribed."

§§ 4219, 4222 R. S. Wis., 1878.

We are aware that there is a conflict of authority on the question whether, in the absence of Federal statute, a state statute of limitations which by its general terms covers an action of trespass for infringement of a patent, without specific mention thereof, bars an action therefor. But it seems to us that the better reason is with the authorities in favor of applying such state statutes. So far as we know, all the authorities upon that side of the question are the following:

Parker v. Hauk, 2 Fish. Pat. Cas. 58.
Parker v. Hall, 2 Id. 62.

Rich v. Ricketts, 7 Blatchf. 230.
Sayles v. Oregon Cent. Ry. Co. 6 Sawyer, 31.
Hayden v. Oriental Mills, 15 Fed. Rep. 605.

See also on the general question of state statutes of limitations in the Federal courts:

McCluny v. Silliman, 3 Pet. 270.
Howes v. Nutt, 4 Clifford, 173.

An infringement of a patent being a continuing trespass, the right of action for it as a continuous tort accrues from day to day as the tort is continued. If there is any statute of limitations applicable to such cause of action, the statute extinguishes the right, as time passes, to sue in respect to that part of the continuous trespass which passes from day to day beyond the period of the statute. Now if this statute was applicable, no recovery should have been had for any infringing use of the patented devices prior to September 29, 1879. The extended term of the patent expired on October 4, 1880. The right of recovery, therefore, lay within the narrow limits of substantially one year out of twenty-one.

If this position is correct, it follows as a corollary that the same b[illegible] measure of damages which would apply to an infringement during an original term or during the extended term or any large fraction of either should not apply to this short period; and the learned District Judge who sat in this case below erred in overruling the point when presented to him several times as indicated in our assignment of errors. The true doctrine, we think, is well laid down in Walker on Patents at § 562, and in the following cases which he cites:

Birdsall v. Coolidge, 93 U. S. 70.
Judson v. Bradford, 3 Bann. & Ard. 549.
Wooster v. Simonsen, 16 Fed. Rep. 680.
Westcott v. Rude, 19 Id. 834.
Bates v. Railroad Co. 32 Id. 628.
Williamantic Thread Co. v. Clark Thread Co. 27 Id. 865.
Asmus v. Freeman, 34 Id. 903.

These cases sustain the rule of proportionate limitation of damages not only where the term is shorter in duration, but where the infringement is smaller in extent, by reason of covering less than all the devices secured by a patent. We think we have satisfactorily shown that in any view of this patent, the most favorable to the defendant in error, infringement cannot be successfully asserted as to anything more than the fourth claim. If so the conclusion follows, that at least the question should have been submitted to the jury, whether the plaintiff below was entitled to the full measure of her royalty claimed on account solely of the infringement of the fourth claim for one year. Consequently, even if our prior points are considered untenable, material errors were committed in this respect by the court below, and the judgment should be reversed and a new trial ordered. We beg leave, however, to submit to the court in closing, that the principal contentions of our brief, viz., that this patent is absolutely invalid on three separate grounds; that this county is not liable even if there was a patentable invention and infringement thereof; and that the plaintiff has no title to the cause of action in suit, are abundantly sustained by the facts, the principles and the authorities which we have given, and that the judgment should be reversed with directions to dismiss the complaint.

CHARLES E. SHEPARD,

Of Counsel for Plaintiff in Error.

J. H. McCrory,
District Attorney.
and Attorney for Plaintiff in Error.

Office Supreme Court U. S.
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THE SUPREME COURT
OF THE UNITED STATES

OCTOBER TERM, 1890.

NO. 61.

THE COUNTY OF FOND DU LAC,
Plaintiff in Error,
vs.
SARAH MAY,
Defendant in Error.

In Error to the Circuit Court of the United
States for the Eastern District
of Wisconsin.

BRIEF FOR DEFENDANT IN ERROR.

M. C. BURCH,
Duane E Fox *For Deft.*

GRAND RAPIDS, MICHIGAN:
W. W. HART'S ARCADE STEAM BOOK AND JOB PRINTING HOUSE.
1890.

THE SUPREME COURT

OF THE UNITED STATES.

THE COUNTY OF FOND DU LAC,
Plaintiff in Error,
vs.
SARAH MAY,
Defendant in Error.

BRIEF FOR DEFENDANT IN ERROR.

The plaintiff in error summarizes its case under four headings:

FIRST: They say, "There was neither any valid patentable device nor an infringement thereof in the case at bar."

SECOND: They say, "That the county is not liable for infringement of a patentable device used in its jail." In other words, *ultra vires.*

THIRD: They say, "That the plaintiff is not the owner of the cause of action in the suit, if any such exists."

Fourth: They plead the statute of limitations of six years in the State of Wisconsin.

As Defendant in Error contends that the first position taken is of least importance, the second, third and fourth will be first considered in this brief.

FIRST.

We therefore first discuss the question of *ultra vires.* It is admitted that in some respects there is a difference between express municipal corporations existing by express charter or act of the Legislature and those quasi corporations such as counties and towns which are ordinarily recognized in the constitutions of most of the states; but there is also a plain distinction between the conditions of townships and counties in some of the states and others; that is, in many of the states, as in Wisconsin and Michigan, by express provision of the constitution counties and townships are made bodies corporate and politic, while in other states, like Ohio, there is such constitutional provision, and their local courts have held them to be mere sub-divisions of the State Government, for governmental purposes.

If this distinction is borne in mind, the error of the Plaintiff in Error will be more clearly understood, and the application or mis-application of their authorities more easily discerned.

The constitution and laws of Wisconsin makes a county a body corporate and politic, with power to sue and be sued, and under the laws of Wisconsin, as in other states, it becomes the duty of the county to build a jail or prison for the confinement of prisoners, and it is unimportant whether this was done through a contractor who agreed to do it for the county, or whether it was done by a county committee, who procured materials and put them in. It is as well settled as the law of patents that *using* is an infringement as well as *constructing*.

The act of Congress grants a monopoly, "To make, use, and vend." that is, the patentee is granted the monopoly to make, to use, and to vend, and it is absurd, in our view, to say that because a contractor made the jail that the county could use it without infringement, unless further proof is shown that the construction was acquiesced in by the patentee, whereby he is estopped from recovering damages for infringement, and that question does not arise in this case. We will not therefore waste time in arguing the question of the liability of the county for the *use* of the patent, merely because the patent might have been erected within the jail by some contractor. The county might as well claim the right to retain a library of books that had been stolen because it was the purchaser of the books in good faith. It might just as well in the building of its court house appropriate the bricks, or stone, or iron columns, or slate roof of private parties and place them in its building, and then deny liability because it was beyond the power of the county, as such, to mis-appropriate a person's private property.

Plaintiff in error bases its argument and position very largely on the case of *Jacobs vs. Hamilton County, 1 Bond, page 500*, which was based upon *Mighels vs. Commissioners, 7 Ohio State, page 110.*

The mis-application is almost too plain for consideration, and the distinction is so wide between the principal involved in the Mighels case and that in the Jacobs case quoted in plaintiff's brief, that it seems strange that the error was ever fallen into in the Jacobs case.

In the Mighels case, the Supreme Court of Ohio held, that the county could not be liable without express act of the Legislature, creating such liability for injuries received by a person in falling down a hatch-way in a public building.

Upon the strength of this, in *Jacobs vs. Hamilton County*, Judge Leavett hastily reached the conclusion, that a county could not be held liable for the infringement of a patent. The one holding, viz: the principle laid down in the Mighels case, was plainly good law, as there was no act of the Legislature providing for such liability, and common law was against it. It was held, that the whole body of tax-payers embraced within a county were not at fault because a man fell through a hatch-way and injured himself, because they had no part or parcel in the transaction. The accident benefitted no one; it was of no benefit to the people of Hamilton County that Mighels should fall through a hatch-way. But Jacobs owned a patent under an act of Congress, which provided that it should not be infringed; that he should have the monopoly of it, and the county appropriated the patent in violation of the rights granted him by Congress. They took his property. They took it for a beneficial purpose, viz: to restrain their prisoners from running at large; they appropriated it to protect the public.

If there was not property in his patent, there was none in the jail of which his patent became a part. If his patent was of no benefit to the county, then the jail itself was of no benefit to the county, and it is plain that as the law provided that there should be a jail, and that it should be constructed by the county commissioners, and when constructed should be maintained for the beneficial uses of the county, that the county would be liable either for the price of anything mis-appropriated and put in, or in tort, that is, in an action on the case for the wrong they had done to the owner.

The whole subject has been very thoroughly discussed by many judges at circuit, in this series of cases. It was passed upon by Judge Dyer adversely to Plaintiffs in Error in this case, *27 Federal Reporter, 691*, who followed the decision of Mr. Justice Davis, in *May vs. Commissioners of Johnson County, Indiana*, at the Indiana circuit (not reported, but a certified copy of which we produce.) It was ably discussed by Judge Jackson of this circuit, in *May vs. the County of Logan* (*30 Federal Reporter, 250*), and again in *Same vs. Seneca County*; by Judge Barr, in *May vs. Mercer County, Dist. of Kentucky, 30 Fed. Rep. 246.* Again by Judge Thayer, in *May vs. the Counties of Ralls, Jefferson and St. Genevieve, Eastern Dist. of Missouri, 31 Fed. Rep. 473.* Again by Judge Brown in *May vs. the County of Saginaw*, *32 Fed. Rep. 629*.

To their decisions we can add nothing. In every case above cited, counsel for defendant in error made arguments, and entire familiarity with those opinions, and the cases cited, warrants the belief that the single case of *May vs. County of Juneau*, is the only break in this long line of cases upon this point in our favor.

SECOND.

In answer to the third of the series of positions taken by the Plaintiff in Error, that the plaintiff is not the owner of the cause of action in suit, if any such exists, in the short time allowed counsel in which to prepare, we simply desire to say, that the argument by counsel upon the basis of the decision in *Moore vs. Marsh*, *7 Wallace*, *515*; and *Dibble vs. Auger*, *7th Blatchford*, *86*, is a misapplication of effort and authorities. The facts in this case are utterly at variance with the facts in those, as has been determined at the circuit in nearly all of the cases last above cited by us. The only exception to the rule was that against County of Juneau, decided by his Honor Judge Bunn. Judge Dyer first passed upon the question in this case adversely to plaintiff in error. Judge Bunn then passed upon the same in *May vs. Juneau County*, and a few days subsequent Judge Barr, in *May vs. Wercer County*, decided in favor of Plaintiff in Error. In the following month Judge Jackson in *May vs. Logan* and *Seneca Counties*, carefully reviewed the subject, also differing with Judge Bunn in a very well prepared opinion to which the Court is cited, and then the question was discussed at great length, carefully examined, Judge Bunn's opinion carefully reviewed, and the opposite opinion given by Judge Brown in *May vs. County of Saginaw*, to which particular attention is invited, because it is the principal question examined, and more than ordinary care was given to the subject as stated in respect to the Plaintiff in Error's second position. It would seem to be well nigh impossible to present the matter in any new or different light than those taken by several judges at circuit, and we refer to them without further argument, in the belief that a careful examination of the reasonings in these various cases will show the fallacy which counsel for plaintiff here attempted to advance as their ground of error.

THIRD.

The fourth position taken by counsel for Plaintiff in Error, is that of the State statute ofl imitations. It may be stated that in this case the patent was granted to Edwin May, on October 4th, 1859, for the period of fourteen years, and therefore expired on the 4th day of October, 1873; that they were extended in accordance with the provisions of the law then in force for seven years from the fourth day of October 1873, and therefore expired on the fourth day of October, 1880. Proof was offered showing that the Defendant County had been in use of the patent during the entire extended period thereof, and the cause of action was brought within six years from the time of the expiration of the extended letters patent; but while it is admitted that there is a conflict of authority among the Circuit Courts of the United States, upon the subject of the right to intervene with a State statute of limitations, the matter has not yet been passed upon to the knowledge of this counsel by this Court, and by far the greatest weight of authority is now in favor of the position that the State statute of limitations cannot be invoked to cut off a right granted under the act of Congress to a patentee. In addition to the cases cited by counsel on both sides of this question, we cite the various discussions of the subject by the learned Judges in the various May cases, which we have heretofore referred to as found in the Federal Reporters, viz: the case at bar; *May vs. Buchanan County, Iowa, 29 Fed. Rep. 469*; *Same vs. Counties of Logan* and *Seneca, 30 Fed. Rep. 250; Same vs. the Counties of Rall, Jefferson, and St. Genevieve, 31 Fed. Rep. 473*, and cases cited therein.

FOURTH.

We take up in this order the first proposition of the Plaintiff in Error, viz: "There was neither any valid patented device, nor an infringement thereof, in the case at bar."

It must be remembered that this patent was dated October 4th, 1859, and from its number, 25662, it will be seen at a glance that the patentee was early in the field of invention with this device; that during fourteen years of its lifetime it came into extensive use, and never, until the case of *May vs. Johnson County, in 1872*, does it appear that any question was raised as to its validity, and the Record discloses the fact that it was then held valid in a suit before his Honor, Justice Davis, presiding at Circuit. It was extended from October 4th, 1873, for seven years, so as to expire October 4th, 1880, it thus having covered a period of 21 years, during which the owner of the patent, who died in 1880, had remained in undisturbed enjoyment and possession of it.

The invention was that of means whereby a jailor in approaching the places where prisoners are confined, might with perfect safety from behind a grated door and grated corridors which furnished ample means for observation, control the movements of the prisoners within, and compel them to move before him from the outside corridor in which, presumably, they might be allowed to roam at will for any desired period of time, into an inside corridor, and fasten doors to a grating behind them, and then the jailor entering the outside corridor compelled the prisoners to pass from thence into their cells and fasten them there by means of the doors temporarily until the doors could be securely locked.

The real gist of the May invention consisted in a mechanism which could be used by the jailor, in connection with an interposing wall or grating separating him from the prisoners, while ordering them to their respective cells or rooms, and fastening such rooms or cells securely. Like all true inventions, it was in the nature of a discovery.

It was admitted by the defense, that the use of an interposing wall or grating, between the prisoners and the jailor, with suitable mechanism for controlling the prisoners, and fastening them into their cells or any room, was new. It is proven that it was useful; first, because the patent was granted by the patent office, making a *prima facie* case of novelty and utility; second, the patent had been repeatedly sustained by the courts; third, it had been recognized as a valid and useful invention by the Patent Office; fourth, it had been recognized by numerous parties, who had paid royalties for the use of the same; fifth, its utility cannot be questioned by the defendants, for the reason that they adopted it in their jail; sixth, the plaintiff's expert testified positively that the May devices did involve patentable invention, and this expert is admitted by the defendants' brief to have been a competent expert; seventh, there was not an iota of proof offered by the defense against the validity and patentability of the invention.

Therefore the court and the jury *were bound to find*, that the May device involved patentable invention, and the only question involved in the issue was the question of infringement. This question was properly left to the jury by the Court. It would have been serious error for the Court, in the face of the patent, the testimony as to its novelty, the invention involved in it, and the evidence that it was useful and had been adopted, to have charged the jury that the patent was invalid, as he was requested to do.

Now, as to the question of infringement. On the trial the jury had before it evidence as to use since 1869 in defendant's jail, covering the entire extended period of the patent. Next, it had the patent itself, with drawings and specifications before it in evidence; it had before it an accurate model of the plaintiff's invention, which was shown and explained by the expert, Moulton. It also had before it a model of the defendant's contrivance shown and explained by the expert, commented upon by counsel.

Under proper instructions the question of mechanical equivelants and of infringement was submitted fully and carefully to the jury, and after this the jury deliberately passed upon the three claims in issue, and rendered a verdict accordingly. It would not have been proper for the court to have instructed the jury that there was no infringement; it was a question of fact which could only be decided by them under the circumstances, no single witness testified that it was not an infringement; no evidence was offered tending to show that it was not an infringement, and under the circumstances it is difficult to conceive what point counsel for defendant, (Plaintiff in Error here,) can raise as to the devices in the Waupung prison and the Chemung County jail. The record plainly shows that they were admitted in evidence, and all the force they were entitled to give them.

With reference to the second point made, on page 19 of the Defendant's brief, we answer: If all the argument of counsel is true, if there was no invention, if the device was not novel, or if it was mere aggregation and not an operative combination, it occurs to us that it would have been very wise on the trial of the case for the defendants to have produced some evidence of want of novelty or of prior use. But as the case was tried, not a particle of evidence of this sort was introduced, either from expert witnesses, or by way of documents, but on the contrary it was admitted by defendant's counsel, that the use of a device, which controlled the prisoners on one side of a grating or a wall, and was operated by the jailor from the other side of the grating, thereby keeping a protecting wall or grating between the prisoners and operator at all times, was novel. This, as before stated, constitutes the gist of the May invention. The admission is, in their brief (page 18,) stated as follows.

"We candidly admit that the precise device here claimed, including the interposed barrier, and used in a jail for the protection of the jailor, and the prevention of escape, has not been before used so far as the Record shows." It appeared by the evidence and is admitted (see plaintiff's brief page 20,) that the construction produced was a novel construction, and constituted a jail or prison, operating on different principles from any jail or prison ever before known or used. This will relieve it from the charge of being an aggregation. It will be understood that this invention did not exist merely in the use of lugs, levers, and rods, but consisted in *a prison built upon an entirely new theory and principle*, so far as it enabled the jailor to control the prisoners without coming in personal contact with them.

We thus close our reply to the arguments in Defendant's brief, but we notice several matters by way of assignment of error, which are not argued in Defendant's brief, and to such as are worthy of attention, we reply:

First, as to royalty: the undisputed evidence in the case showed, that the established royalty of the Plaintiff's assignor was fifty dollars a cell, for the use of the patent or any portion thereof, for whatever period it was used, and there was not a word of testimony to the contrary. This is demonstrated by the charge of the Court, (see Plaintiff's brief, p. 13,) in which he says: "The undisputed evidence shows, I think, the fixed royalty of fifty dollars for each cell, at which the Plaintiff's device, or the right to use it, was sold by the patentee in his life-time.

Second: The records contain various documents in the case of *May vs. Johnson County;* and they are alluded to in page five of the Plaintiff's brief. Respecting the admission of this, Plaintiff in Error is in serious mistake. Counsel for Plaintiff on the trial below, upon a question of the admission of evidence, offered to read from the charge of Justice Davis, in the case of *May vs. Johnson County;* to which counsel for Defendant below objected because it was no reported case, and there was no authentication of the same, whereupon counsel for Plaintiff below exhibited a certificate from the Circuit Court for the District of Indiana, to the correctness of the charge, and thereupon Defendant's counsel still objected because it was not known what the pleadings and situation were in the case of *May vs.*

Johnson County; and thereupon Plaintiff offered for the use of the Court certified copy of all the proceedings in the Johnson County case, which were of record, (and which are included in the record in this case,) to show that the case was identical with this, and these were introduced, not for the purpose of being read to the jury, but simply for the purpose of offering the charge of Justice Davis to the Court in a properly authenticated form. As stated in the Record, the objection was of no force, no reason being assigned therefor, and it is plain, even if counsel's claim for it was true, that no harm could have come from the reading of it.

THIRD. As to the assignments of error number seventeen and eighteen, which quote at length from the charge of the Court, we insist that it is correct law, a fair, reasonable summary of the law, as it has been elucidated and established by the decisions of the Supreme and Circuit Courts of the United States in patent cases.

FOURTH. As to the argument and statement in counsel's brief, on pages 18 and 19, relative to use of devices in street cars and other machinery, previous to 1859, we deny that the witness Moulton ever so stated, or that such is the fact, or that such would appear to be the fact from any decision or records in this case or otherwheres.

We believe there is no error in this record.

M. C. BURCH,
Isaac E Fox *Of Counsel.*